

TFW  
2681



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RESUBMISSION OF APPLICATION PAPERS

APPLICANT: Hans-Jochen Morper DOCKET NO: P97,1957-01  
SERIAL NO.: 08/932,704 ART UNIT: 2681  
FILED: September 18, 1997 EXAMINER: C. Craver  
TITLE: Method for Call Control of Communication Terminal Equipment  
Wirelessly Connected to Communications Networks

Mail Stop Amendment  
5 Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

10 During a database survey, Applicant became aware that no action from  
the U.S. Patent Office had ever been received based on Response E, mailed  
December 3, 2001.

A follow-up telephone to the U.S. Patent Office revealed that Response E  
had been properly received and entered by the U.S. Patent Office, but that for  
15 unexplained reasons had never been acted upon by the U.S. Patent Office. As a  
result of numerous calls to Examiner Craver and his supervisor, Examiner  
Casaro, it was determined that the best course for proceeding with this  
application would be to resubmit the papers in the application, thereby triggering  
a responsive action.

20 Applicant is therefore resubmitting all papers in the above-identified  
application (Appendix), including the last response (Response E), with a copy of  
the stamped postcard indicating receipt of Response E by the U.S. Patent Office.

BEST AVAILABLE COPY

Applicant respectfully requests an action based on this resubmission of application papers.

Applicant invites the Examiner to contact its undersigned representative in the event there are any questions or problems.

Respectfully submitted,



Mark Bergner (Reg. No. 45,877)

Mark Bergner  
SCHIFF HARDIN, LLP  
PATENT DEPARTMENT  
6600 Sears Tower  
Chicago, Illinois 60606-6473  
(312) 258-5779  
Attorney for Applicants  
Customer Number 26574

#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on November 29, 2005.

Pam Vander Meer



## APPENDIX

HON. COMMISSIONER OF PATENTS & TRADEMARKS  
WASHINGTON, D.C. 20231

SIR:

PLEASE APPLY A RECEIPT STAMP HERETO AND MAIL TO  
ACKNOWLEDGE RECEIPT OF THE ATTACHED:

Hans-Jochen Morper

APPLICANT

December 3, 2001

MAILING DATE

MB 26965-0452 due 10/02

Response E - Two month extension of Time

015400.80

TYPE OF DOCUMENT(S)

P97,1957 01 - 09/932,704

REFERENCE NUMBER

SCHIFF HARDIN & WAITE

261330

SCHIFF HARDIN & WAITE

Check Date: 12/03/01

INVOICE DATE	DESCRIPTION	INVOICE NUMBER	AMOUNT
12/03/01	COMMISSIONER OF PATENTS AND TR- TWO MONTH EXTENSION OF TIME- P97.1957 01 MB	P97.1957 01	400.00
		Total	400.00



# SCHIFF HARDIN & WAITE

CHICAGO OFFICE  
TELEPHONE (312) 258-5500-  
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Patent Department  
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WASHINGTON OFFICE  
1101 Connecticut Ave., N.W.  
Suite 600  
Washington, DC 20036-4390  
TELEPHONE (202) 778-6400  
TELECOPIER (202) 778-6460

In re application of: Hans-Jochen Morper

Serial No.: 08/932,704

GROUP ART UNIT: 2681

Filed: September 18, 1997

EXAMINER: C. Craver

For: **"METHOD FOR CALL CONTROL OF COMMUNICATION TERMINAL EQUIPMENT WIRELESSLY CONNECTED TO COMMUNICATION NETWORKS"**

Assistant Commissioner for Patents  
Washington D.C. 20231

## RESPONSE E

SIR:

Transmitted herewith is an amendment in the above-identified application.

No additional fee is required.

The fee has been calculated as shown below.

CLAIMS AS AMENDED						
	(2) CLAIMS REMAINING AFTER AMENDMENT		(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	*11	MINUS	**20	X 0	( ) X 9.00 ( ) X 18.00	
INDEP. CLAIMS	*2	MINUS	**3	X0	( ) X 42.00 (X ) X84.00	
Application amended to contain any multiple dependent claims not previously paid for.				( ) YES  ( ) NO	( ) \$130.00 ( ) \$260.00 ONE TIME	
			TOTAL ADDITIONAL FEE FOR THIS AMENDMENT			

\*If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.  
the "Highest Number Previously Paid For" IN THIS SPACE is less than 20 write "20" in this space.

■ Applicant petitions the Commissioner of Patents and Trademarks to extend this time for response to the Office Action dated July 2, 2001 for 12 months so that the period for response is extended to December 2, 2001. A check in the amount of \$ 400.00 is attached to cover the cost of the extension. A duplicate copy of this sheet is enclosed.

☐ A check in the amount of \$ \_\_\_\_\_ is attached.

☐ A check for \$ \_\_\_\_\_ accompanying IDS under 37 CFR 1.97(c) is attached

☐ A check for \$ \_\_\_\_\_ and Petition for Consideration of IDS under 37 CFR 1.97(d) is attached.

■ The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to Account No. 501519. A duplicate of this sheet is enclosed.

When phoning re this application, please call 312/258-5786. **CUSTOMER NO. 26574**

SCHIFF HARDIN & WAITE

BY Mark Bergner (Reg. No. 45,877)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on December 3, 2001.

Mark Bergner

NAME OF APPLICANT'S ATTORNEY

Mark Bergner  
SIGNATURE

December 3, 2001

DATE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RESPONSE E

APPLICANT: Hans-Jochen Morper DOCKET NO: P97,1957-01  
SERIAL NO.: 08/932,704 ART UNIT: 2681  
FILED: September 18, 1997 EXAMINER: C. Craver  
TITLE: Method for Call Control of Communication Terminal Equipment  
Wirelessly Connected to Communications Networks

Assistant Commissioner for Patents,  
Washington, D.C. 20231

Dear Sir:

This amendment is responsive to the non-final Office Action dated July 2, 2001.

REMARKS

Claims 7-15, 17, and 18 are pending in the application. The claims were rejected  
as follows:

Claims / Section	35 U.S.C. Sec.	References / Notes
10, 11, 13- 15, 17	§103(a) Obviousness	<ul style="list-style-type: none"><li>• Wiedeman (U.S. Patent 5,448,623); and</li><li>• Akhavan (U.S. Patent 5,673,308).</li></ul>
7-9	§103(a) Obviousness	<ul style="list-style-type: none"><li>• Wiedeman (U.S. Patent 5,448,623);</li><li>• Akhavan (U.S. Patent 5,673,308); and</li><li>• Admission of Prior Art (APA).</li></ul>
12, 18	§103(a) Obviousness	<ul style="list-style-type: none"><li>• Wiedeman (U.S. Patent 5,448,623);</li><li>• Akhavan (U.S. Patent 5,673,308); and</li><li>• APA.</li></ul>

Applicants have provided arguments for distinguishing the present invention from the  
combination of Wiedeman, Akhavan, and the admitted prior art.

**35 U.S.C. §103(a), Claims 10, 11, 13-15 and 17 Obviousness over Wiedeman '623  
in view of Akhavan '308**

1. *Akhavan does not disclose rerouting the call, given non-availability of the  
called wireless communication terminal equipment, to the sub-communication network  
using the appertaining base station—its base station is not actively involved in the*

routing.

In the Office Action, the Examiner, on p. 3, 2<sup>nd</sup> paragraph, states that Akhavan teaches the rerouting element of the present invention at 21/46-22/2. Applicants respectfully disagree. Akhavan uses the home location register 305 for the rerouting,  
5 not the base station (which would have to be the base station 308 in Akhavan).

In more detail, Akhavan, at 21/46-22/2, discloses a standard cellular telephone system coupled to a standard public switched telephone network (PSTN) 301 supporting the personal phone number (PPN) service. The base station 308 in the "home" zone 309 is connected via landline to the public switched telephone network  
10 301. If the cordless base station 308 has a cellular capability, there is a radio link between the nearest base station 304 supported by the mobile switching center 303 of the cellular telephone system. When a subscriber portable station or hand set 310 comes within the "home" zone 309, base station 308 causes a request for cellular call forwarding to be transmitted to the cellular telephone system through base station 304  
15 to mobile switching center 303. The location and PPN of subscriber station 310 is stored in a home location register 305, coupled to the mobile switching center via data lines 311. The home location register 305 keeps track of the location of "home" zone 309. When a subscriber station 310 roams out of the "home" zone, a radio link is established with the nearest cellular base station 304. This location is transmitted  
20 through the mobile register 305 so that incoming calls for the subscriber 310 can be routed to the correct base station to establish cellular communication. Thus, the rerouting of Akhavan does not take place according to the invention by rerouting the call using the base station.

Akhavan discloses that the routing of an incoming (to the subscriber station)  
25 telephone call is always and only organized by the mobile switching center 303 (or 313

in the figure), which as part of the standard public switched telephone network 301, whereby the location and PPN of subscriber station 310 is stored in a home location register 305, which is coupled to the mobile switching center 303 via data lines 311. More precisely, the routing and especially the rerouting of an incoming telephone call, where the subscriber station is out of the home area, is independent from the cordless base station in the home zone. This is well established by the following sentence of Akhaven (21/63-22/2):

When a subscriber station 310 roams out of the "home" zone, a radio link is established with the nearest cellular base station 304. This location is transmitted through the mobile register 305 so that incoming calls for the subscriber 310 can be routed to the correct base station to establish cellular communication.

The home base station is not actively involved in the routing. This is in contrast to the present invention in which incoming telephone calls are always routed in a first step to the base stations of a home area. Only in the case of non-availability of the called wireless communication terminal equipment in the home area, the home base station initiates a rerouting of the call to the sub-communication network. This procedure is absolutely in contrast to the scenario described by Akhaven.

*2. Wiedeman does not disclose that the sub-communication network may be the source of a call setup for rerouting the call.*

Wiedeman discloses a situation where a remote location called the "caller" 50 desires to make a telephone call to a cellular telephone user 30 that is roaming and is not located in a terrestrial cellular telephone service area (TCTSA). The caller 50 uses the PSTN 21 to call the user's HG12 or perhaps some other equivalent location. The call is transferred by the PSTN switch to the user's HG12. The HG12 equipment 23

processes the call and, by accessing the home user data base 31. finds that the user  
30 is roaming in the satellite service area 24 and thereby knows to route the call to the  
AG.

Thus, Wiedeman does not disclose that the sub-communication network may be  
5 the source of a call setup for rerouting the call, which is an elementary part of the  
present invention.

3. *There is no motivation to combine Akhaven and Wiedeman since neither*  
*teaches the inventive rerouting according to the present invention, and since one does*  
10 *not provide a solution to problems raised in the other to result in the present invention.*

Akhaven controls the routing of a call by the mobile switching center without  
addressing the base station of the home area, while the present invention specifically  
addresses the base station of the home area first. From a technical point of view, it is  
also clear that the mobile switching center can never be a part of the base station of the  
15 home area, since it has to be a part of and associated with the whole communication  
network. Incoming telephone calls have to be switched even when the base station of  
the home area is switched off. Wiedeman does not solve this issue in that it does not  
disclose that the sub-communication network may be the source of a call setup for  
rerouting the call. The functional use of the base station with respect to the call routing  
20 are at odds with one another, and thus could not be combined together. Thus,  
Applicants respectfully contend that one of ordinary skill in the art would not combine  
Akhaven with Wiedeman for the present inventive solution.

25 **35 U.S.C. §103(a), Claims 7-9, 12, and 18 Obviousness over Wiedeman '623 in  
view of Akhavan '308 and APA**

4. *Applicants rely on the above arguments to overcome the §103 rejections for the*

remaining claims.

For these reasons, Applicants assert that the claim language clearly distinguishes over the prior art, and respectfully request that the Examiner withdraw the §103(a) rejection from the present application.

5

**Conclusion**

Inasmuch as each of the rejections have been overcome by the arguments presented, and all of the Examiner's suggestions and requirements have been satisfied, it is respectfully requested that the present application be reconsidered, the rejections be withdrawn and that this application be passed to issue.

10

Respectfully submitted,

Mark Bergner (Reg. No. 45,877)

15

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20

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D C 20231 on December 3, 2001.

25

Mark Bergner  
Mark Bergner - Attorney for Applicants



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/932,704 09/18/97 MORPER

H P97.1957

SCHIFF, HARDIN & WAITE  
PATENT DEPARTMENT  
6600 SEARS TOWER  
CHICAGO IL 60606-6473

WM41/0702

EXAMINER

CRAVER, C

ART UNIT

PAPER NUMBER

2681

DATE MAILED:

07/02/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/932,704

Applicant(s)

Morper

Examiner

Charles Craver

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 13, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: ☐ approved ☒ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:



Art Unit: 2681

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 10, 11, 13-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan in view of Wiedeman et al.

#### **Regarding claims 10 and 15,**

Akhavan discloses a method for controlling calls in a communication network comprising the steps of

calling, using a telephone number, a wireless terminal (310) connected to base stations of a home area (304), said base stations being connected to terminals of the communication network (see FIG 3), the wireless terminal further wirelessly connectable to a sub-communication network (309),

switching calls directed to the wireless terminal to a base station in the home area (col 21 lines 51-54),

Art Unit: 2681

initiating a call setup for a rerouted call in the sub-network using a phone number of the mobile unit, and

rerouting the call, given non-availability of the wireless terminal in the home area, using the base station, to the sub-communication network, using call deflection (col 21 line 46-col 22 line 2).  
*(Using THE BASE STN)*

Akhavan further discloses the utility of ISDN systems (col 11 lines 20-31, col 9 line 63-col 10 line 22).

Akhavan does not disclose a step of determining the availability of the mobile unit using the base station.

Wiedeman discloses that it is useful in a signaling network comprising a sub-communication network and a number of home area base stations (12), to determine the availability of a mobile unit in the home area prior to setting up a rerouting of a call (col 7 lines 37-49).  
*W/ EQUIPMENT 23 - REROUTS*  
*BUT HOW IS THIS DONE? IN W*  
*W CHECKS DATABASE (SO MUST BE FREE-LOADED)*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to Akhavan. Akhavan discloses the utility of providing the home area network with means for tracking the location of the user, either in the home area or the sub-network (col 21 lines 59-67). Wiedeman further adds that it is useful to allow the home area base station to make the assessment of the availability of the user. Adding said feature to Akhavan would reduce the number of elements in the network by consolidating features at the base station.

Regarding claim 11,

*- BUT THERE ARE FUNCTIONAL ISSUES TO ADDRESS AS WELL*

Art Unit: 2681

Akhavan discloses that the availability of the mobile unit is determined by the use of a paging method incorporating a base station (column 7 line 52-column 8 line 5).

**Regarding claim 13,**

Akhavan discloses a public switching network (PSTN) and ISDN associated with the communication networks (column 9 line 63-column 10 line 22).

**Regarding claim 14,**

Akhavan further discloses that the rerouting of the call is realized using call deflection or call forwarding, an ISDN standard (column 17 lines 40-47, column 9 line 63-column 10 line 22).

**Regarding claim 17,**

please see the rejection of claim 11 above.

3. Claims 7, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan in view of Wiedeman as applied to claim 15 above, and further in view of the applicant's own admission of prior art.

**Regarding claims 8 and 9,**

Akhavan and Wiedeman, while disclosing a call deflection method, does not disclose that the paging procedure and wireless base station-to-mobile unit connection is implemented according to a DECT or GAP or CAP standard.

Art Unit: 2681

The applicant admits as prior art in the background of the invention the method of using a DECT standard or a GAP or CAP standard in a wireless communication connection, which would include paging (applicant page 1 lines 1-9, page 2 lines 5-9).

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the DECT and CAP or GAP standards, taught by the applicant, into the invention of Akhavan in view of Wiedeman, as it would allow the invention to work along with set standards.

**Regarding claim 7,**

Akhavan in view of Wiedeman, while disclosing a call deflection method, does not disclose that the communication terminal is implemented according to one of an SO and UKO-ISDN access.

However, it is well known in the art to apply an access standard such as SO or UKO-ISDN access to an ISDN connection in a wireless communication protocol, and the examiner takes official notice as such.

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the SO or UKO-ISDN standards, taught by the applicant, into the invention of Akhavan in view of Wiedeman as it would allow the invention to work along with known standards.

Art Unit: 2681

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan in view of Wiedeman as applied to claim 10 above, and further in view of the applicant's own admission of prior art.

Please see the rejection of claim 8 above.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan in view of Wiedeman as applied to claim 15 above, and further in view of the applicant's own admission of prior art.

Please see the rejection of claim 8 above.

#### ***Response to Arguments***

6. Applicant's arguments with respect to claims 10 and 15 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

**7. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

Art Unit: 2681

**Or:**

(703) 872-9314 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

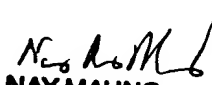
Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, sixth floor (receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

cc  
C. Craver  
June 27, 2001

  
NAY MAUNG  
PRIMARY EXAMINER

SCHIFF HARDIN & WAITE

248463

INVOICE DATE	DESCRIPTION	INVOICE NUMBER	AMOUNT
04-10-01	ONE MONTH EXTENSION FEE- P97,1957-01- MB	04/10/2001C	110.00
			110.00

CHICAGO OFFICE  
TELEPHONE (312) 258-5500  
FACSIMILE (312) 258-5700

**SCHIFF HARDIN & WA**

**PATENT DEPARTMENT**

**6600 SEARS TOWER**

**CHICAGO, ILLINOIS 60606-6473**

Chicago  
Washington  
New York  
Herrillville  
Dublin

**CUSTOMER NUMBER 26574**

In re application of: **HANS-JOCHEN MORPER**

DOCKET NO: **P97,1957-01**

Serial No: **08/932,704**

GROUP ART UNIT: **2681**

Filed: **September 18, 1997**

EXAMINER: **C. Craver**

For: **Method for Call Control of Communication Terminal Equipment  
Wirelessly Connected to Communications Networks**

Assistant Commissioner for Patents,  
Washington, D.C. 20231

Transmitted herewith is an amendment in the above-identified application.

☒ No additional fee is required.

☐ The fee has been calculated as shown below.

CLAIMS AS AMENDED						
	(2) CLAIMS REMAINING AFTER AMENDMENT		(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	* 11	MINUS	** 20	-0-	( ) X 9.00 ( ) X 18.00	
INDEP. CLAIMS	* 02	MINUS	** 03	-0-	( ) X 40.00 (X) X 80.00	
Application amended to contain any multiple dependent claims not previously paid for.				( ) YES (X) NO	( ) \$135.00 ( ) \$270.00 ONE TIME	
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					NONE	

\* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20 write "20" in this space.

- ☒ Applicant petitions the Commissioner of Patents and Trademarks to extend this time for response to the Office Action dated **December 20, 2000** for **1** month(s) so that the period for response is extended to **April 20, 2001**. A check in the amount of **\$ 110.00** is attached to cover the cost of the extension.
- ☐ A check for \$ \_\_\_\_\_ is enclosed to cover the cost of \_\_\_\_\_ extra independent claim.
- ☐ A check for \$ \_\_\_\_\_ accompanying IDS under 37 CFR 1.97(c) is attached.
- ☐ A check for \$ \_\_\_\_\_ and Petition for Consideration of IDS under 37 CFR 1.97(d) is attached.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. **50-1519**. A duplicate of this sheet is enclosed.
- When phoning regarding this application, please call (312) 258-5779

BY Mark Bergner (Reg. No. 45,877)  
Mark Bergner

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on April 10, 2001.

Mark Bergner  
Mark Bergner Attorney for Applicants



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AMENDMENT D

APPLICANT: Hans-Jochen Morper DOCKET NO: P97,1957-01  
SERIAL NO.: 08/932,704 ART UNIT: 2681  
FILED: September 18, 1997 EXAMINER: C. Craver  
TITLE: Method for Call Control of Communication Terminal Equipment  
Wirelessly Connected to Communications Networks

5 Assistant Commissioner for Patents,  
Washington, D.C. 20231

Dear Sir:

10 This amendment is responsive to the Office Action, Paper 12, dated  
December 20, 2000.

IN THE CLAIMS

Please cancel claims 1-6 without prejudice.

15 Please amend claims 7-9 and 15 as indicated by the following replacement claims,  
referring to Appendix A for the mark-ups.

7. (Amended) The method according to claim 10, wherein the communication  
terminal is realized by one of an SO access and UKO-ISDN basic access.

20 8. (Amended) The method according to claim 10, wherein wireless connection of  
wireless communication terminal equipment to the base stations in the home area is  
realized according to one of DECT standard.

25 9. (Amended) The method according to claim 10, wherein wireless connection of  
wireless communication terminal equipment to basic stations is realized according to one of  
a DECT standard and a CAP standard.

15. (Amended three times) A method for controlling calls in a public ISDN communication network, comprising the sequential steps of:

calling, using a telephone number, wireless communication terminal equipment wirelessly connected to base stations of a home area, the base stations being connected to communication terminals of the communication network, and the wireless communication terminal equipment being additionally wirelessly connected to an ISDN sub-communication network of the ISDN communication network;

switching calls directed to a called wireless communication terminal equipment to an appertaining base station in the home area using the communication network;

determining an availability of the called wireless communication terminal equipment being determined by said appertaining base station in the home area in response to said switching of calls;

initiating a call setup for a rerouted call in the sub-communication network using a mobile telephone number of the called wireless communication terminal equipment, the rerouted call being initiated for the respective wireless communication terminal equipment; and

rerouting the call, given non-availability of the called wireless communication terminal equipment, to the sub-communication network using the appertaining base station and using an ISDN performance feature of "call deflection".

Please cancel claim 16 without prejudice.

## REMARKS

Claims 1-18 are pending in the application. The status of the claims is as follows:

Claims Section /	35 U.S.C. Sec.	References / Notes
1	§102(b) Anticipation	• Wiedeman (U.S. Patent 5,448,623).
2, 3, 5, 6, 10, 11, 13-17	§103(a) Obviousness	• Wiedeman (U.S. Patent 5,448,623); and • Akhavan (U.S. Patent 5,673,308).
7, 8, 9, 18	§103(a) Obviousness	• Wiedeman (U.S. Patent 5,448,623); and • Admission of Prior Art (APA).
4, 12	§103(a) Obviousness	• Wiedeman (U.S. Patent 5,448,623); • Akhavan (U.S. Patent 5,673,308); and • APA.

5 Applicants have cancelled independent claim 1 and dependent claims 2-6, and amended claims 7-9 to depend from claim 10 (claim 10 being a combination of claims 1 and 2). Claim 15 has been amended to include the limitation of claim 16. Applicants have provided arguments for distinguishing the present invention from the combination of Wiedeman and Akhavan.

10 **35 U.S.C. §102(b), Claim 1 Anticipation by Wiedeman '623**

1. *Claim 1 has been canceled from the application.*

**35 U.S.C. §103(a), Claims 2, 3, 5, 6, 10, 11, 13-17 Obviousness over Wiedeman '623 in view of Akhavan '308**

15 2. *The combination of Wiedeman and Akhavan does not obviate the present invention because the element of initiating a call setup in the sub-communication network in sequence with the other elements is not taught by Wiedeman and Akhavan either alone or in combination.*

The Examiner acknowledged that Wiedeman does not expressly disclose that the sub-communication network may be the source of a call setup for rerouting the call (p. 3, under paragraph 5), but cites Akhavan as providing the teaching for using the sub-communication network to set up the rerouting of such a call (p. 4, first full paragraph). The Examiner then states that adding the feature of Akhavan to Wiedeman would allow a subsequent incoming call to be directly routed to the sub-network and avoid excessive call rerouting.

Applicants respectfully disagree, because if the feature of Akhavan were added to Wiedeman, the system would be unworkable, or at the very least, extremely inefficient.

The Examiner has analogized Wiedeman's element 16 in Figure 3 (the remote TSN/Active Gateway) to the sub-communication network of the present invention. According to Wiedeman (at 7/36-65), a caller 50 wishing to contact a cellular telephone user 30 accesses the user's home gateway (HG) 12 via the PTSN 21. If the home gateway (HG) 12 determines that the active gateway (AG) 16 is not the user's HG 12, the HG 12 requests a call setup to the AG 16 via the packet network 32.

Given the Scheme of Wiedeman, however, Akhavan would have to suggest using the active gateway AG 16 of Wiedeman (what the Examiner is equating to the sub-communication network) to initiate the call setup for a rerouted call, and not the home gateway HG 12, as is actually indicated by Wiedeman. It is very unclear what would drive the active gateway AG 16 in Wiedeman to initiate a setup, as described in the invention, or taught by Akhavan. The telephone call of caller 50 would somehow have to be directed to the active gateway AG 16, but there appears to be no direct mechanism in Wiedeman to do this, nor is there any suggestion for doing so provided by Akhavan.

3. *The personal phone number (PPN) in Akhavan is forwarded to the cellular telephone system in the framework of establishing communications between a mobile device and a base station, and not in the rerouting of a call within the sub-communication network.*

5       The Examiner states that Akhavan teaches letting the sub-communication base station be the source of the call setup for rerouting the call using a mobile telephone number of the mobile unit (p. 4, carryover paragraph).

          However, Akhavan establishes the call forwarding at an earlier stage than the present invention. "The key instructions that are sent constitute a request for cellular call  
10 forwarding when a base station has established communication with an appropriate subscriber hand-set or portable station." 17/44-47. "Thus, the communications from the transmitter 103 to the cellular telephone system will contain the PPN of the hand-set currently in communication with the base station 100..." 17/60-63.

          Since the home base station of the present invention transmits the PPN at the time a  
15 call is generally routed to it (each and every time, after a check to see that the mobile device is not accessible by the home system), it does not require the utilization of the forwarding function of the cellular phone system as discussed above.

          All remaining claims in the application now contain a combination of claims 1 and 2 (i.e., claim 10), notably, the limitation pertaining to a rerouting of the call that is initiated in  
20 the sub-communication network using the mobile telephone number of the called wireless communication terminal equipment. Applicants believe that this combination is not taught by any combination of the references cited against it.


          Applicants rely on these arguments for the patentability of independent claim 15 and all remaining dependent claims in the application.

For these reasons, Applicants assert that the amended claim language clearly distinguishes over the prior art, and respectfully request that the Examiner withdraw the §103(a) rejection from the present application.

**Conclusion**

Inasmuch as each of the rejections have been overcome by the amendments and arguments presented, and all of the Examiner's suggestions and requirements have been satisfied, it is respectfully requested that the present application be reconsidered, the rejections be withdrawn and that this application be passed to issue.

Respectfully submitted,

  
\_\_\_\_\_  
Mark Bergner (Reg. No. 45,877)  
SCHIFF HARDIN & WAITE  
PATENT DEPARTMENT  
6600 Sears Tower  
Chicago, Illinois 60606-6473  
(312) 258-5779  
Attorney for Applicants  
**Customer Number 26574**

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D C 20231 on April 10, 2001.

  
\_\_\_\_\_  
Mark Bergner - Attorney for Applicants

**APPENDIX A  
MARKED UP CLAIMS**

7. (Amended) The method according to claim 10 [5], wherein the communication  
5 terminal is realized by one of an SO access and UKO-ISDN basic access.

8. (Amended) The method according to claim 10 [1], wherein wireless connection of  
wireless communication terminal equipment to the base stations in the home area is  
realized according to one of DECT standard.  
10

9. (Amended) The method according to claim 10 [1], wherein wireless connection of  
wireless communication terminal equipment to basic stations is realized according to one of  
a DECT standard and a CAP standard.

15 15. (Amended three times) A method for controlling calls in a public ISDN  
communication network, comprising the sequential steps of:

calling, using a telephone number, wireless communication terminal equipment  
wirelessly connected to base stations of a home area, the base stations being connected to  
communication terminals of the communication network, and the wireless communication  
20 terminal equipment being additionally wirelessly connected to an ISDN sub-communication  
network of the ISDN communication network;

switching calls directed to a called wireless communication terminal equipment to  
an appertaining base station in the home area using the communication network;

determining an availability of the called wireless communication terminal equipment  
25 being determined by said appertaining base station in the home area in response to said  
switching of calls;

initiating a call setup for a rerouted call in the sub-communication network using a mobile telephone number of the called wireless communication terminal equipment, the rerouted call being initiated for the respective wireless communication terminal equipment;  
and

- 5 rerouting the call, given non-availability of the called wireless communication terminal equipment, to the sub-communication network using the appertaining base station and using an ISDN performance feature of "call deflection".



R

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APPLICANT

Amendment "D", cover sheet in  
duplicate, one month ext. fee

\$110.00

TYPE OF DOCUMENT(S)

Appendix "A" marked-up claims.

April 10, 2001

MAILING DATE

P97,1957-01

08/932,704

REFERENCE NUMBER

M. Bergner due: April 20, 2001

SCHIFF HARDIN & WAITE



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Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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TS  
08/032,704

09/18/97

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P97.1957

SCHIFF, HARDIN & WAITE  
PATENT DEPARTMENT  
6600 SEARS TOWER  
CHICAGO IL 60606-6473

WM02/1220

EXAMINER

DRAVER, C

ART UNIT

PAPER NUMBER

2681

DATE MAILED:

12/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Art Unit: 2681

## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on 10-6-2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/932,704 is acceptable and a CPA has been established. An action on the CPA follows.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Wiedeman et al, US Pat 5,448,623 (newly cited).

Wiedeman discloses a method for controlling calls in a communication network comprising the sequential steps of

calling, using a telephone number (col 7 lines 37-41), a wireless terminal (30) connected to base stations of a home area (12), said base stations being connected to terminals of the communication network (50, see FIG 4), the wireless terminal further wirelessly connectable to a sub-communication network (16),

CONNECTED

Art Unit: 2681

switching calls directed to the wireless terminal to a base station in the home area (col 7 lines 37-45),

in response to said switching, said base station determining availability of said wireless terminal (col 7 lines 45-49), and

rerouting the call, given non-availability of the wireless terminal, using the base station, to the sub-communication network (col 7 line ~~50~~<sub>60</sub>-col 8 line 14).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedeman as applied to claim 1 above, and further in view of Akhavan, of record.

**Regarding claim 2,**

While disclosing applicant's invention of claim 1 above, Wiedeman does not expressly disclose that the sub-communication network may be the source of a call setup for rerouting the call.

Akhavan discloses that it is useful, in a system which offers a mobile terminal the ability to communicate with a network and a subcommunication network (abstract, column 22 lines 3-12

Art Unit: 2681

and 22-36, figures 3 and 4), and the ability to reroute calls from the network to the sub-communication network (column 21 line 46- column 22 line 2 and column 22 lines 37-65), to let the sub-communication base station be the source of the call setup for rerouting the call using a mobile telephone number of the mobile unit (column 17 lines 35-65).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to add such a feature to Wiedeman. Wiedeman teaches the utility of forwarding incoming calls from a network to a sub-network. Akhavan teaches that it is useful to allow the sub-communication network to set up the rerouting of such a call. Adding the feature of Akhavan to Wiedeman would allow a subsequent incoming call to be directly routed to the sub-network and avoid excessive call rerouting.

**Regarding claims 3,**

Akhavan discloses that the availability of the mobile unit is determined by the use of a paging method incorporating a base station (column 7 line 52-column 8 line 5).

**Regarding claim 5,**

Akhavan discloses a public switching network (PSTN) and ISDN associated with the communication networks (column 9 line 63-column 10 line 22).

**Regarding claim 6,**

Akhavan further discloses that the rerouting of the call is realized using call deflection or call forwarding, an ISDN standard (column 17 lines 40-47, column 9 line 63-column 10 line 22).

Art Unit: 2681

6. Claims 7, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedeman as applied to claim 1 above, and further in view of the applicant's own admission of prior art.

**Regarding claims 8 and 9,**

Wiedeman, while disclosing a call deflection method, does not disclose that the paging procedure and wireless base station-to-mobile unit connection is implemented according to a DECT or GAP or CAP standard.

The applicant admits as prior art in the background of the invention the method of using a DECT standard or a GAP or CAP standard in a wireless communication connection, which would include paging (applicant page 1 lines 1-9, page 2 lines 5-9).

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the DECT and CAP or GAP standards, taught by the applicant, into the invention of Wiedeman, as it would allow the invention of Wiedeman to work along with set standards.

**Regarding claim 7,**

Wiedeman, while disclosing a call deflection method, does not disclose that the communication terminal is implemented according to one of an SO and UKO-ISDN access.

However, it is well known in the art to apply an access standard such as SO or UKO-ISDN access to an ISDN connection in a wireless communication protocol, and the examiner takes official notice as such.

Art Unit: 2681

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the SO or UKO-ISDN standards, taught by the applicant, into the invention of Wiedeman as it would allow the invention of Wiedeman to work along with known standards.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedeman in view of Akhavan as applied to claim 3 above, and further in view of the applicant's own admission of prior art.

Regarding claim 4, please see the rejection of claim 8 above.

8. Claims 10, 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedeman in view of Akhavan.

Regarding claim 10,

Wiedeman discloses a method for controlling calls in a communication network comprising the sequential steps of

calling, using a telephone number (col 7 lines 37-41), a wireless terminal (30) connected to base stations of a home area (12), said base stations being connected to terminals of the communication network (50, see FIG 4), the wireless terminal further wirelessly connectable to a sub-communication network (16),

switching calls directed to the wireless terminal to a base station in the home area (col 7 lines 37-45),

Art Unit: 2681

in response to said switching, said base station determining availability of said wireless terminal (col 7 lines 45-49), and

rerouting the call, given non-availability of the wireless terminal, using the base station, to the sub-communication network (col 7 line 50-col 8 line 14).

Wiedeman does not specifically disclose that the sub-communication network may be the source of a call setup for rerouting the call.

Akhavan discloses that it is useful, in a system which offers a mobile terminal the ability to communicate with a network and a subcommunication network (abstract, column 22 lines 3-12 and 22-36, figures 3 and 4), and the ability to reroute calls from the network to the sub-communication network (column 21 line 46- column 22 line 2 and column 22 lines 37-65), to let the sub-communication base station be the source of the call setup for rerouting the call using a mobile telephone number of the mobile unit (column 17 lines 35-65).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to add such a feature to Wiedeman. Wiedeman teaches the utility of forwarding incoming calls from a network to a sub-network. Akhavan teaches that it is useful to allow the sub-communication network to set up the rerouting of such a call. Adding the feature of Akhavan to Wiedeman would allow a subsequent incoming call to be directly routed to the sub-network and avoid excessive call rerouting.

**Regarding claim 11,**



Art Unit: 2681

Akhavan discloses that the availability of the mobile unit is determined by the use of a paging method incorporating a base station (column 7 line 52-column 8 line 5).

**Regarding claim 13,**

Akhavan discloses a public switching network (PSTN) and ISDN associated with the communication networks (column 9 line 63-column 10 line 22).

**Regarding claim 14,**

Akhavan further discloses that the rerouting of the call is realized using call deflection or call forwarding, an ISDN standard (column 17 lines 40-47, column 9 line 63-column 10 line 22).

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedeman in view of Akhavan as applied to claim 10 above, and further in view of the applicant's own admission of prior art.

Please see the rejection of claim 4 above.

10. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedeman in view of Akhavan.

**Regarding claim 15,**

Wiedeman discloses a method for controlling calls in a communication network comprising the sequential steps of

Art Unit: 2681

calling, using a telephone number (col 7 lines 37-41), a wireless terminal (30) connected to base stations of a home area (12), said base stations being connected to terminals of the communication network (50, see FIG 4), the wireless terminal further wirelessly connectable to a sub-communication network (16),

switching calls directed to the wireless terminal to a base station in the home area (col 7 lines 37-45),

in response to said switching, said base station determining availability of said wireless terminal (col 7 lines 45-49), and

rerouting the call, given non-availability of the wireless terminal, using the base station, to the sub-communication network (col 7 line 50-col 8 line 14).

Wiedeman does not specifically disclose that the ISDN standard of 'call deflection' is utilized in the rerouting of the call.

Akhavan discloses that it is useful, in a system which offers a mobile terminal the ability to communicate with a network and a subcommunication network (abstract, column 22 lines 3-12 and 22-36, figures 3 and 4), and the ability to reroute calls from the network to the sub-communication network (column 21 line 46- column 22 line 2 and column 22 lines 37-65), to reroute the call using call deflection or call forwarding, an ISDN standard (column 17 lines 40-47, column 9 line 63-column 10 line 22).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to add such a feature to Wiedeman, as it was a standard at the time of the invention, and by

Art Unit: 2681

allowing Wiedeman to operate using known standards, a more robust and flexible system is possible.

**Regarding claim 16,**

Akhavan discloses further that the sub-communication base station can be the source of the call setup for rerouting the call using a mobile telephone number of the mobile unit (column 17 lines 35-65).

**Regarding claims 17,**

Akhavan discloses that the availability of the mobile unit is determined by the use of a paging method incorporating a base station (column 7 line 52-column 8 line 5).

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedeman in view of as applied to claim 15 above, and further in view of the applicant's own admission of prior art.

Please see the rejection of claim 4 above.

***Conclusion***

**12. Any response to this action should be mailed to:**

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**or faxed to:**

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Art Unit: 2681

**Or:**

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")


Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, sixth floor (receptionist).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

CC  
C. Craver  
December 13, 2000

  
NAY MAUNG  
PRIMARY EXAMINER



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Vedene D. Green  
Supervisory Legal Instruments Examiner  
Phone Number: (703) 305-4376

Earline Green  
Supervisory Legal Instruments Examiner  
Phone Number: (703) 305-4901

Fax No. (703) 308-9051 or (703) 308-9052

## Attention: Policy on Returning Phone Calls

A PTO-wide customer service standard is if a PTO employee being called is not available, they will return your call by the next business day, or, if you request, an alternate point of contact will be provided. Technology Center 2700 is committed to meeting this service standard. If you have called any employee in our Technology Center and have not received a return phone call within one (1) business day or have not been provided another point of contact, please contact the Technology Center at 703-306-5631. We ensure that you will receive a return phone call, from an employee with the ability to assist you, within four (4) business hours of this contact. We appreciate your help in assisting us to help you.

The employees of Technology Center 2700



# A Brief Summary of Some Significant Rule Changes

Unless otherwise specified in the rule, the effective date for the PBG-FINAL RULE is November 7, 2000.

## Amendment Practice (37 CFR 1.121)

### Specification/Claims

- Amendment by paragraph replacement or rewritten claim in clean form
- Marked-up version showing changes must be supplied

See § 1.121 Slides on PBG-FINAL RULE Webpage for suggested amendment FORMAT (Optional now; mandatory March 1, 2001)

## Small Entity Status (37 CFR 1.27) - FORMS NO LONGER REQUIRED (Eff. Sept. 8, 2000)

- Mere written assertion (e.g., use check box on Application Transmittal Forms) is acceptable

## Abstract and Title Length (37 CFR 1.72)

- Abstract now limited to 150 words (PBG)
- Title now limited to 500 characters (AIPA)

## Application Data Sheet (ADS) (37 CFR 1.76) NEW

- Use of ADS encouraged for more accurate capture of bibliographic data. Data in ADS not needed in declaration

## After Allowance Practice (37 CFR 1.85(c) and 1.136)

- No extensions of time permitted to file corrected or formal drawings

## Elimination of Issue Fee Preauthorizations (37 CFR 1.311)

- Preauthorizations prior to Notice of Allowance no longer permitted

## Rocket Docket Established for Designs (37 CFR 1.155)

- Excess submissions plus \$900 fee is required

## Proof of Authority of Legal Representative (37 CFR 1.44)

### THIS RULE HAS BEEN DELETED (Eff. Sept. 8, 2000)

- Oath/Dec. (\$1.03) should identify legal rep for deceased/incapacitated inventor

## Parts of Applications on CD-R or CD-ROM (37 CFR 1.52 (e), 1.58, 1.96 & 1.821)

- Large tables, computer program listings, and bio-sequences now allowed on CD

# Patent Business Goals Final Rule

65 Fed. Reg. 14604 (September 4, 2000)

1239 Off. Gen. Pat. Office 11 (September 10, 2000)



## USPTO's PBG-FINAL RULE

webpage has helpful related information at one location:

<http://www.uspto.gov/web/offices/ocao/olia/pbg/index.html>

### This site includes:

- Listing of Affected Rules
- Training & Implementation Materials Including Training Slides, Q & A's, Summaries, Effective Date Chart, Forms
- Changed by Recent Rules, etc.

### Contact

Bob Spar (703) 306-5167 or  
Hiram Bernstein (703) 305-8713  
for any PBG Change

Joe Narcavage (703) 305-1795  
for 37 CFR 1.121

Amendment Practice Changes

Eugenia Jones (703) 306-5586  
for 37 CFR 1.27 Small Entity  
Changes

**Notice of References Cited**Application No.  
**08/932,704**

Applicant(s)

**Morper**Examiner  
**Charles Craver**Group Art Unit  
**2681**

Page 1 of 1

**U.S. PATENT DOCUMENTS**

	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	5,448,623	9/1995	Wiedeman et al	455	430
B					
C					
D					
E					
F					
G					
H					
I					
J					
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L					
M					

**FOREIGN PATENT DOCUMENTS**

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Delivery Weekend Holiday		

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Delivery Attempt	Time	Employee Signature
Mo. Day	AM PM	
Delivery Attempt	Time	Employee Signature
Mo. Day	AM PM	
Delivery Date	Time	Employee Signature
Mo. Day	AM PM	
Signature of Addressee or Agent		
X		
Name - Please Print		
X		

## STOMER USE ONLY

MODE OF PAYMENT:	<input type="checkbox"/> WAIVER OF SIGNATURE (Domestic Only) Additional merchandise insurance is void if waiver of signature is requested. I wish delivery to be made without obtaining signature of addressee or addressee's agent (if delivery employee judges that article can be left in secure location) and I authorize that delivery employee's signature constitutes valid proof of delivery.
NO DELIVERY <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday	Customer Signature

## FROM: (PLEASE PRINT)

PHONE ( 312 ) 258-5500

SCHIFF HARDIN & WAITE  
Patent Department  
6600 Sears Tower  
Chicago, IL 60606-6473

Siemens 26965-0452 P97,1957-01  
Morper

## TO: (PLEASE PRINT)

PHONE ( )

Assistant Commissioner for Patents  
Box CPA  
Washington, D C 20231

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Express Mail # EJ077703972 US

BOX CPA

dated Oct. 6, 2000  
HON. COMMISSIONER OF PATENTS & TRADEMARKS  
WASHINGTON, D.C. 20231

SIR:

PLEASE APPLY A RECEIPT STAMP HERETO AND MAIL TO  
ACKNOWLEDGE RECEIPT OF THE ATTACHED:

Hans-Jochen Morper

APPLICANT

October 6, 2000

MAILING DATE

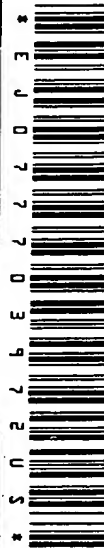
M. Bergner due: Oct. 6, 2000

CPA Transmittal Letter in duplicate; Preliminary Amendment "C";  
Fee: \$710.00 Appointment of  
TYPE OF DOCUMENT(S)  
associate power of Attorney and  
change of address.  
08/932,704 P97,1957-01

REFERENCE NUMBER

SCHIFF HARDIN & WAITE

Mailing Label



CERTIFICATE OF MAILING

COPY

"Express Mail" Mailing Label Number EJ077703972US

Date of Deposit: October 6, 2000

I hereby certify that this correspondence is being deposited with the United States Postal "Express Mail Post Office to Addressee" service under 37 CFR 1.10(c) on the date indicated above and is addressed to:

**Assistant Commissioner for Patents  
Box CPA  
Washington, D.C. 20231**

This is a continuation application for:

Hans-Jochen Morper

P97,1957-01

**Enclosed are the following documents:**

Continued Prosecution Application (CPA) Request Transmittal  
form in duplicate;

Preliminary Amendment;

Fee: \$710.00

Appointment of Associate Power of Attorney

Change of Address of Applicants' Representative

Postcard.

  
\_\_\_\_\_  
Signature of person mailing documents and fees

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

APPLICANT(S): Hans-Jochen Morper      DOCKET NO      P97,1957-01  
SERIAL NO.: 08/932,704      ART UNIT: 2744  
FILED: September 18, 1997      EXAMINER: C. Craver  
TITLE: Method for Call Control of Communication Terminal Equipment  
Wirelessly Connected to Communication Networks

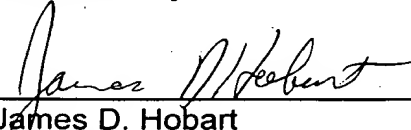
Assistant Commissioner for Patents,  
Washington, D.C. 20231

**APPOINTMENT OF ASSOCIATE POWER OF ATTORNEY**

Sir:

I am an attorney designated on the Power of Attorney for the above-referenced application. I hereby appoint Mark Bergner (Reg. No. 45,877) as an associate attorney, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

Submitted by,



(Reg. No. 24, 149)

James D. Hobart  
SCHIFF HARDIN & WAITE  
PATENT DEPARTMENT  
6600 Sears Tower  
Chicago, Illinois 60606-6473  
(312) 258-5781  
Attorney for Applicant(s)

DATE: October 6, 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
CHANGE OF ADDRESS OF APPLICANTS' REPRESENTATIVE

COPY

APPLICANT(S): Hans-Jochen Morper      DOCKET NO      P97,1957-01  
SERIAL NO.: 08/932,704      ART UNIT: 2744  
FILED: September 18, 1997      EXAMINER: C. Craver  
TITLE: Method for Call Control of Communication Terminal Equipment  
Wirelessly Connected to Communication Networks

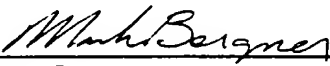
Assistant Commissioner for Patents,  
Washington, D.C. 20231

Sir:

Members of the firm of Hill & Simpson designated on the original Power of Attorney have merged into the firm of Schiff Hardin & Waite. All future correspondence for the above-referenced application therefore should be sent to the following address:

**SCHIFF HARDIN & WAITE**  
**Patent Department**  
**6600 Sears Tower**  
**Chicago, Illinois 60606-6473**

Submitted by,

  
\_\_\_\_\_  
Mark Bergner (Reg. No. 45,877)  
SCHIFF HARDIN & WAITE  
Patent Department  
6600 Sears Tower  
Chicago, Illinois 60606-6473  
Telephone: (312) 258-5779  
Attorneys for Applicants.

DATE: October 6, 2000

SCHIFF HARDIN & WAITE

238138

VOICE DATE	DESCRIPTION	INVOICE NUMBER	AMOUNT
10-06-00	CPA FILING FEE- P97,1957-01-MB	10/06/2000D	710.00
			710.00

# CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

(Only for Continuation or Divisional Applications under 37 CFR 1.53(d))

Address to:  <b>Assistant Commissioner for Patents</b> Box CPA Washington DC 20231	Attorney Docket No.:	P97,1957-01
	First Named Inventor:	HANS-JOCHEN MORPER
	Express Mail Label No.:	EJ077703972US
	Date:	October 6, 2000

This is a request for a   X   continuation or    divisional application under 37 CFR 1.53(d), (continued prosecution application (CPA)) of prior application number   08/932,704   filed on   September 18, 1997  , entitled: **Method for Call Control of Communication Terminal Equipment Wirelessly Connected to Communication Networks**

1. ☐ Enter the unentered amendment previously filed on under 37 CFR 1.116 in the prior nonprovisional application.
2. ☒ A preliminary amendment is enclosed.
3. ☐ This application is filed by fewer than all the inventors named in the prior application, 37 CFR 1.53(d)(4).
  - a. ☐ DELETE the following inventor(s) named in the prior nonprovisional application:
  - b. ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4. ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. ☐ Information Disclosure Statement (IDS) is enclosed:
  - a. ☐ PTO-1449
  - b. ☐ Copies of IDS Citations

CLAIMS AS FILED				
(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) BASIC FEE \$710.00
TOTAL CLAIMS	18	0	\$18.00	0
INDEPENDENT CLAIMS	03	0	\$80.00	0
	ANY MULTIPLE DEPENDENT CLAIMS? <input type="checkbox"/> YES <input checked="" type="checkbox"/> NO			0
			TOTAL FILING FEE ->	\$710.00

6. Small entity status:
  - a. ☐ A small entity statement is enclosed
  - b. ☐ A small entity statement was filed in the prior non-provisional application and such status is still proper and desired.
  - c. ☐ Is no longer claimed.
7. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required in connection with this application, or credit any overpayment to Account No. 501519. A duplicate copy of this sheet is enclosed.
8. ☒ A check in the amount of \$   710.00   to cover the filing fee is enclosed.
9. ☐ Other: Applicant petitions the Commissioner for Patents to extend this time for response to the Office Action dated            for    month(s) so that the period for response is extended to           . A check in the amount of \$            is attached to cover the cost of the extension.

**Correspondence Address:**

Schiff Hardin & Waite  
 Patent Department  
 6600 Sears Tower  
 Chicago, IL 60606-6473  
 Telephone (312) 258-5500 Fax (312) 258-5700

Respectfully submitted,

  
 Mark Bergner (Reg. No. 45,877)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**PRELIMINARY AMENDMENT "C"**

**ACCOMPANYING A CPA**

APPLICANT: Hans-Jochen Morper    DOCKET NO:    P97,1957-01

5    SERIAL NO:    08/932,704                      GROUP ART UNIT: 2744

FILED:    September 18, 1997                      EXAMINER: C. Craver

TITLE:                      Method for Call Control of Communication Terminal  
Equipment Wirelessly Connected to Communication  
Networks

Assistant Commissioner for Patents

10    Washington, D.C. 20231

Sir:

Please amend the above-identified application as follows:

**IN THE CLAIMS:**

Please amend the following claims 1, 10, 15.

- 15            1. (Twice amended) A method for controlling calls in a  
communication network, comprising the sequential steps of:  
              calling, using a telephone number, wireless communication  
terminal equipment wirelessly connected to base stations of a home area,  
the base stations being connected to communication terminals of the  
20    communication network, and the wireless communication terminal  
equipment being additionally wirelessly connected to a sub-  
communication network of the communication network;  
              switching calls directed to a called wireless communication  
terminal equipment to an appertaining base station in the home area  
25    using the communication network; [.]

determining an availability of the called wireless communication terminal equipment [being determined] by said appertaining base station in the home area in response to said switching of calls; and

5 rerouting the call, given non-availability of the called wireless communication terminal equipment, to the sub-communication network using the appertaining base station.

10. (Twice amended) A method for controlling calls in a communication network, comprising the sequential steps of:

10 calling, using a telephone number, wireless communication terminal equipment wirelessly connected to base stations of a home area, the base stations being connected to communication terminals of the communication network, and the wireless communication terminal equipment being additionally wirelessly connected to a sub-communication network of the communication network;

15 switching calls directed to a called wireless communication terminal equipment to an appertaining base station in the home area using the communication network; [.]

determining an availability of the called wireless communication terminal equipment [being determined] by said appertaining base station in the home area in response to said switching of calls;

20 rerouting the call, given non-availability of the called wireless communication terminal equipment, to the sub-communication network using the appertaining base station; and

25 initiating a call setup for a rerouted call in the sub-communication network using a mobile telephone number of the called wireless communication terminal equipment, the rerouted call being initiated for the respective wireless communication terminal equipment.



15. (Twice amended) A method for controlling calls in a public ISDN communication network, comprising the sequential steps of:

calling, using a telephone number, wireless communication terminal equipment wirelessly connected to base stations of a home area, the base stations being connected to communication terminals of the communication network, and the wireless communication terminal equipment being additionally wirelessly connected to an ISDN sub-communication network of the ISDN communication network;

switching calls directed to a called wireless communication terminal equipment to an appertaining base station in the home area using the communication network; [.]

determining an availability of the called wireless communication terminal equipment being determined by said appertaining base station in the home area in response to said switching of calls;

rerouting the call, given non-availability of the called wireless communication terminal equipment, to the sub-communication network using the appertaining base station and using an ISDN performance feature of "call deflection".

#### **REMARKS**

These amendments were made based on an interview with the Examiner. The independent claims in the application have been amended to include: 1) the addition of a limitation indicating that the steps of the independent claims are sequential, and 2) breaking out the step of determining the availability of the wireless communication terminal by the home area base station as a distinct and sequential step, as opposed to simply being included as a characterization of the switching step (with no language temporally binding it to the switching of calls).

The Examiner indicated that such changes would patentably distinguish the present invention over the art that has been of record in the case thus far. Applicants thank the Examiner for his time and constructive comments during the interview.

5           Inasmuch as each of the rejections have been overcome by the amendments, and all of the examiner's suggestions and requirements have been satisfied, it is respectfully requested that the present application be reconsidered, the rejections be withdrawn and that this application be passed to issue.

10                           Respectfully submitted,



(Reg. No. 45,877)

15           Mark Bergner  
          SCHIFF HARDIN & WAITE  
          PATENT DEPARTMENT  
          6600 Sears Tower  
          Chicago, Illinois 60606-6473  
          (312) 258-5779  
          Attorneys for Applicant

Date: October 6, 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**TELEPHONE INTERVIEW DISCUSSION POINTS**  
**(INFORMAL)**

5

APPLICANT: Hans-Jochen Morper ATTORNEY DOCKET NO: P97,1957

SERIAL NO: 08/932,704 GROUP ART UNIT: 2744

FILED: September 18, 1997 EXAMINER: C. Craver

10

TITLE: Method for Call Control of Communication Terminal Equipment  
Wirelessly Connected to Communication Networks

Dear Examiner Craver:

Thank you for agreeing to an interview on the above-identified case.

15

The discussion below references the discussion points of the Office Action, Paper 7,  
dated July 6, 2000.

I would like to address the following points in the telephone interview that has been  
arranged for this case on October 5, 2000 at 10:00 EDT.

20

First, however, please note that the firm Hill & Simpson (that your last office action  
was directed to) is in the process of dissolution—a number of attorneys are now associated  
with the firm Schiff Hardin & Waite. I will provide a formal change of address form and  
power of attorney for this case along with my formal response—if you need one prior to the  
interview, please let me know, and we can have one sent.

25

Please consider the following points raised by the Applicants.

1. The base station of the present invention, when an incoming call is in process,  
actively checks the availability of the subscriber station prior to routing the call to the  
subscriber station.

Thus, in contrast to Akavan, it is not the subscriber station that establishes a connection to a base station to transmit its new location, but the base station that searches for the subscriber station. If (in the present invention) the subscriber station does not respond to the questioning base station, the base station reroutes the call to the subcommunication network. Thus, all decisions that have to be taken (such as where to route the call, etc.) are taken in the base station, with the subscriber station remaining passive.

In Akhavan, the subscriber station actively communicates its new location once it has left the home area. Rerouting of the call is carried out at a higher level, i.e., that of the MSC, and not in the base station.

We note that your response considers the decision to move the function of determining the availability of a user at the base station from the MSC to be a routine engineering decision that would help keep the MSC from overuse or to lower system complexity, based on system size and availability. Paragraph 1 of our last filed "Amendment B" was not presented as arguing a limitation in the claim, but rather as an exemplary indicator of the differences that would be required in the telephone system itself that would extend the scope of change to something more than simply a routine engineering decision.

2. Please clarify, regarding claims 2, 10, and 16, whether you understand Akhavan 17/35-65 as actually describing the call forwarding implemented in the present invention, or whether you understand the invention simply to be an obvious variation of Akhavan. Applicants believe that Akhavan does not provide for a setup for a rerouted call with a mobile telephone number of the called wireless terminal equipment of the subcommunication network.

Thank you for your time in reviewing these points prior to our discussion.

Respectfully submitted,



(Reg. No. 45,877)

Mark Bergner  
SCHIFF HARDIN & WAITE  
PATENT DEPARTMENT  
6600 Sears Tower  
Chicago, Illinois 60606-6473  
(312) 258-5779  
Attorney for Applicant(s)

10/04/00 WED 07:16 FAX 312 258 5600

SHW CHICAGO

001

\*\*\*\*\*  
\*\*\* TX REPORT \*\*\*  
\*\*\*\*\*

TRANSMISSION OK

TX/RX NO  
CONNECTION TEL  
SUBADDRESS  
CONNECTION ID  
ST. TIME  
USAGE T  
PGS.  
RESULT

0648

917033059508

10/04 07:14

01'10

4

OK

---

## Schiff Hardin & Waite

PATENT DEPARTMENT  
6600 SEARS TOWER  
CHICAGO, ILLINOIS 60606 USA  
TELEPHONE: 312-258-5779  
TELEFAX: 312-258-5700

### **TELEFAX COVER SHEET**

**TO:** EXAMINER C. Craver Fax # 1(703) 305-9508  
**FROM:** Attorney Mark Bergner  
**DATE:** October 4, 2000  
**SUBJECT:** Method for Call Control of Communication Terminal  
Equipment Wirelessly Connected to Communication  
Networks

#### CONFIDENTIALITY NOTICE

*THIS FAX TRANSMISSION CONSISTS OF CONFIDENTIAL AND/OR ATTORNEY CLIENT PRIVILEGED AND/OR ATTORNEY WORK PRODUCT INFORMATION, AND IS INTENDED FOR THE ADDRESSEE ONLY. IF YOU RECEIVE THIS FAX IN ERROR, PLEASE CONTACT **Schiff Hardin & Waite** BY COLLECT TELEPHONE CALL TO ARRANGE FOR THE RETURN OF THIS MATERIAL. ANY USE OF THIS MATERIAL BY ANYONE OTHER THAN THE ADDRESSEE IS STRICTLY PROHIBITED.*

**Please review the attached telephone interview discussion points.**

**TOTAL NUMBER OF PAGES INCLUDING COVER SHEET: 4**

ION. COMMISSIONER OF PATENTS & TRADEMARKS  
WASHINGTON, D.C. 20231

R ✓

SIR:

PLEASE APPLY A RECEIPT STAMP HERETO AND MAIL TO  
ACKNOWLEDGE RECEIPT OF THE ATTACHED:

Amendment "B"

Form U10 in duplicate

Ext. Fee: \$870.00.

Hans-Jochen Morper

APPLICANT

TYPE OF DOCUMENT(S)

April 6, 2000

MAILING DATE

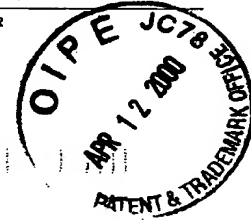
08/932,704 P97,1957

REFERENCE NUMBER

*491-1264 due:  
April 7, 2000*

HILL & SIMPSON  
A PROFESSIONAL CORPORATION

Form 20R







**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/932,704    09/18/97    MORPER

H    P97.1957

EXAMINER

CRAVER, C

ART UNIT

PAPER NUMBER

2744

DATE MAILED:

07/06/00

LMC1/0706

HILL STEADMAN & SIMPSON  
A PROFESSIONAL CORPORATION  
85TH FLOOR SEARS TOWER  
CHICAGO IL 60606

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/932,704

Applicant(s)  
Morper

Examiner  
Charles Craver

Group Art Unit  
2744



☒ Responsive to communication(s) filed on Apr 6, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s); PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2744

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-6, 10-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan, U.S. Patent #5,673,308.

Regarding claims 1, 10 and 15, Akhavan discloses:

a method for controlling calls in a cellular network, comprising  
calling, using a telephone number, wireless terminal equipment (i.e. mobile station)  
wirelessly connected to base stations of a general (reads home) area, said base stations being  
connected to communication terminals in said network (i.e. MSC, MTSO), said mobile unit being  
additionally connected wirelessly to a sub-network of said network (abstract, column 22 lines 3-  
12 and 22-36, figures 3 and 4);

switching calls directed to a called mobile unit to an appertaining base station in said  
general area, availability of said mobile unit being determined by said communication terminals;  
and

Art Unit: 2744

rerouting the call, given non-availability of the called mobile unit, to the sub-communication network (column 21 line 46- column 22 line 2 and column 22 lines 37-65).

Akhavan discloses applicants invention, except that the availability of the mobile unit is determined by the base station, and is thus used in rerouting the call.

However, it was well known in the art at the time the invention was made to determine the availability of a user at the base station (i.e. via HLR, VLR) to keep the MSC from overuse, or, alternately, to incorporate an MSC into a base station so as to lower system complexity. The examiner takes official notice as such. Either option was well known, and would meet applicants limitation of using the base station to determine user availability, and further said base station would inherently be involved in the rerouting of the call in non-availability is determined. It would have been obvious to one skilled in the art to move such a function from an MSC to the base station, because, as mentioned previously, it would keep the MSC from overuse, or in the alternate, lower system complexity, and would thus be a routine engineering decision predicated on system size and ability.

Further regarding claims 2, 10 and 16,

Akhavan discloses further that the sub-communication base station can be the source of the call setup for rerouting the call using a mobile telephone number of the mobile unit (column 17 lines 35-65).

Further regarding claims 6, 14 and 15,

Art Unit: 2744

Akhavan further discloses that the rerouting of the call is realized using call deflection or call forwarding, an ISDN standard (column 17 lines 40-47, column 9 line 63-column 10 line 22).

Regarding claims 3, 11 and 17,

Akhavan discloses that the availability of the mobile unit is determined by the use of a paging method incorporating a base station (column 7 line 52-column 8 line 5).

Regarding claims 5 and 13,

Akhavan discloses a public switching network (PSTN) and ISDN associated with the communication networks (column 9 line 63-column 10 line 22).

3. Claims 4, 7, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan as applied to claim 1 above, and further in view of the applicant's own admission of prior art.

Regarding claims 4, 8 and 9,

Akhavan, while disclosing a call deflection method, does not disclose that the paging procedure and wireless base station-to-mobile unit connection is implemented according to a DECT or GAP or CAP standard.

The applicant admits as prior art in the background of the invention the method of using a DECT standard or a GAP or CAP standard in a wireless communication connection, which would include paging (applicant page 1 lines 1-9, page 2 lines 5-9).

Art Unit: 2744

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the DECT and CAP or GAP standards, taught by the applicant, into the invention of Akhavan, as it would allow the invention of Akhavan to work along with set standards.

Regarding claim 7,

Akhavan, while disclosing a call deflection method, does not disclose that the communication terminal is implemented according to one of an SO and UKO-ISDN access.

However, it is well known in the art to apply an access standard such as SO or UKO-ISDN access to an ISDN connection in a wireless communication protocol, and the examiner takes official notice as such.

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the SO or UKO-ISDN standards, taught by the applicant, into the invention of Akhavan, as it would allow the invention of Akhavan to work along with set standards.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan as applied to claim 10 above, and further in view of the applicant's own admission of prior art.

Please see the rejection of claim 4 above.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan as applied to claim 15 above, and further in view of the applicant's own admission of prior art.

Please see the rejection of claim 4 above.

Art Unit: 2744

*Response to Arguments*

6. Applicant's arguments filed 4-6-2000 have been fully considered but they are not persuasive.

Regarding applicants statements towards claim 1, 10 and 15,

While it is true that the base station of Akhavan does not contain the switching functions present in the invention of the applicant, the invention of claims 1, 10 and 15 do not set forth the invention in such a level of detail such that Akhavan <sup>now 4</sup> ~~does~~ not render the present invention unpatentable. The only difference between the invention of Akhavan and the invention set forth in e.g. claim 1 is that Akhavan does not expressly disclose that the base station may determine the availability of the wireless user. And, as set forth in the rejections above, such a function would be obvious to move to a base station. While Akhavan does not teach a base station that has a call forwarding function in the base station, such a specific limitation is not present in the claims; indeed, claims 1, 10 and 15 merely recite that the call is switched "using the base station". Since the base station of the modified invention of Akhavan would determine if a user was present after receiving a call request, said base station would inherently be involved at least in part in the switching of the call to the sub-communication network.

WHAT MODS TO  
MAKE TO BS?

Further, although it is true that the present invention will generally send a call to the home area base station as opposed to a base station indicated in a register, such a limitation is not present in the claims. Although the claims are interpreted in light of the specification, limitations

Art Unit: 2744

from the specification are not read into the claims. *In re Van Guens*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding applicants statements towards claims 2, 10 and 16,

While applicant asserts that the present invention does not require the use of a forwarding function such as that utilized by Akhavan, and that Akhavan establishes the call forwarding at an earlier stage than the present invention, the examiner asserts that the disclosure of Akhavan that the sub-network may initiate call setup is sufficient to render obvious the limitations present in claims 2, 10 and 16; Akhavan states clearly that the sub-communication network may originate the call setup using a mobile telephone number, see col 17 lines 35-65.

Regarding applicants statements towards claims 6, 14 and 15,

Akhavan discloses the use of call deflection, as recited in col 17 lines 40-47. Further, Akhavan suggests the use of a "full ISDN interface", see col 10 lines 1-6 in a call forwarding environment. Such suggestion would have obviously motivated one of ordinary skill in the art to utilize ISDN features in the invention of Akhavan, especially if it is a standard, as stated by the applicant, see page 5 lines 2-3. Whether or not such a feature is called a "performance" or special feature is inconsequential, given that Akhavan, as shown above, suggests a "full ISDN interface".

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



Art Unit: 2744

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**8. Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 305-9051, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Or:**

(703) 305-9051 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal  
Drive, Arlington, VA., Sixth Floor (Receptionist).

Art Unit: 2744

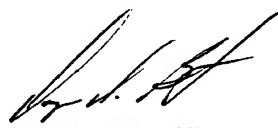
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

cc  
C. Craver  
June 28, 2000

**CHARLES CRAVER**  
**PATENT EXAMINER**

  
DWAYNE B. BOST  
SUPERVISOR OF PATENT EXAMINER  
GROUP 2700



Dear Patent and Trademark Office Customer:

The Technical Support Staff of Technology Center 2700 has undertaken continuous quality improvement efforts to ensure that the accompanying correspondence meets high quality standards, and focuses on good customer service. It is important to us that you are satisfied with the services we provide.

If the contents of the attached correspondence has any clerical omissions, e.g., missing references or pages, illegible text, or errors, please contact Verlene Green or Earline Green, as soon as possible. We will take the appropriate action to expedite the necessary corrections.

Verlene D. Green  
Supervisory Legal Instruments Examiner  
Phone Number: (703) 305-4376

Earline Green  
Supervisory Legal Instruments Examiner  
Phone Number: (703) 305-4901

Fax No. (703) 308-9051 or (703) 308-9052

## Attention: Policy on Returning Phone Calls

A PTO-wide customer service standard is if a PTO employee being called is not available, they will return your call by the next business day, or, if you request, an alternate point of contact will be provided. Technology Center 2700 is committed to meeting this service standard. If you have called any employee in our Technology Center and have not received a return phone call within one (1) business day or have not been provided another point of contact, please contact the Technology Center at 703-306-5631. We ensure that you will receive a return phone call, from an employee with the ability to assist you, within four (4) business hours of this contact. We appreciate your help in assisting us to help you.

The employees of Technology Center 2700

Bill & Simpson

CHECK DATE: 04-06-00

CHECK NO.: 77414

DATE	INVOICE	VOUCHER	COMMENTS	NET		
04-06-00	P97,1957	27025	SIEMENS P97,1957	870.00		
VENDOR: COMMISSIONER OF PATENTS & TRADEMARKS REF #					TOTAL	\$ 870.00

CHICAGO OFFICE  
TELEPHONE (312) 876-0200  
TELECOPIER (312) 876-0898

**HILL & SIMPSON**  
**A PROFESSIONAL CORPORATION**  
**ATTORNEYS AND COUNSELORS AT LAW**  
**85TH FLOOR SEARS TOWER**  
**CHICAGO, ILLINOIS 60606**

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CRYSTAL CITY  
ARLINGTON, VIRGINIA  
22202  
TELEPHONE (703) 415-1515

In re application of: Hans-Jochen Morper

DOCKET NO: P97,1957

Serial No: 08/932,704

GROUP ART UNIT: 2744

Filed: September 18, 1997

EXAMINER: C. Craver

For: **"METHOD FOR CALL CONTROL OF COMMUNICATION TERMINAL  
EQUIPMENT WIRELESSLY CONNECTED TO COMMUNICATION NETWORKS"**

Assistant Commissioner for Patents,  
Washington, D.C. 20231

Transmitted herewith is an amendment in the above-identified application.

☒ No additional fee is required.

The fee has been calculated as shown below.

CLAIMS AS AMENDED						
	(2) CLAIMS REMAINING AFTER AMENDMENT		(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	* 18	MINUS	** 20	-0-	( ) X 9.00 ( ) X 18.00	
INDEP. CLAIMS	* 03	MINUS	** 03	-0-	( ) X 39.00 ( ) X 78.00	
Application amended to contain any multiple dependent claims not previously paid for.				( ) YES (X) NO	( ) \$130.00 ( ) \$260.00 ONE TIME	
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					NONE	

\* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20 write "20" in this space.

- ☒ Applicant petitions the Commissioner of Patents and Trademarks to extend this time for response to the Office Action dated **October 7, 1999** for 3 months so that the period for response is extended to **April 7, 2000**. A check in the amount of \$ **870.00** is attached to cover the cost of the extension.
- ☐ A check for \$ \_\_\_\_\_ is enclosed to cover the cost of \_\_\_\_\_ extra independent claim.
- ☐ A check for \$ \_\_\_\_\_ accompanying IDS under 37 CFR 1.97(c) is attached
- ☐ A check for \$ \_\_\_\_\_ and Petition for Consideration of IDS under 37 CFR 1.97(d) is attached.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. **08-2290**. A duplicate of this sheet is enclosed.
- When phoning regarding this application, please call (312) 876-0200 Ext. **3899**

BY Steven H. Noll (Reg. No. 28,982)  
Steven H. Noll

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on **April 6, 2000**.

Steven H. Noll  
Steven H. Noll Attorney for Applicants

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**AMENDMENT "B"**

5      APPLICANT:      Hans-Jochen Morper      ATTORNEY DOCKET NO:      P97,1957  
SERIAL NO:      08/932,704      GROUP ART UNIT:      2744  
FILED:      September 18, 1997      EXAMINER:      C. Craver  
TITLE:      Method for Call Control of Communication Terminal Equipment  
Wirelessly Connected to Communication Networks

10      Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

15      In response to the Office Action paper number 4, dated October 7, 1999, Applicant  
herewith amends the application as follows:

**IN THE CLAIMS**

Please amend claims 1, 10, and 15 as follows:

On page 10:

20      in line 10 of claim 1, before "said", insert --by--.

On page 12:

in line 10 of claim 10, before "said", insert --by--.

25      On page 14:

in line 2, before "said", insert --by.

**REMARKS**

***Summary***

Claims 1-18 are pending the present application. In the last office action, claims 1-3, 5-6, 10-11, and 13-17 were rejected under 35 U.S.C. §103(a) as being obvious in light of *Akhavan*. Claims 4, 7-9 were rejected under 35 U.S.C. §103(a) as being obvious in light of *Akhavan* and applicant's admitted prior art (APA).

Applicants have provided typographical corrections to independent claims 1, 10, and 15, and have provided arguments that to show that the present invention is nonobvious in light of *Akhavan*.

***§103(a) Rejection of Claims 1-3, 5, 6, 10, 11, and 13-17 over Akhavan***

***Claims 1, 10 and 15***

1. Applicants incorporation of the switching function into the base station is not an obvious variation in light of *Akhavan* because it does not require a call forwarding function to be present in the cellular telephone system available to the subscriber.

Applicant's respectfully assert that the Examiner's characterization of incorporating the MSC into a base stations so as to lower system complexity and prevent overuse of the MSC as being obvious represents an incomplete picture of the present invention. While Applicants do not disagree that engineering decisions could play a role in making such determinations, the operative differences between the present invention and *Akhavan* are of a nature such that this architecture would not have been obvious for these reasons.

The *Akhavan* invention requires that the cellular telephone system have a cellular call forwarding service available. "The use of this control technique... requirements are that the cellular telephone system have cellular call forwarding service available to a subscriber..."

18/7-15. This is required because the base station of *Akhavan* does not have the switching capability of the present invention and implements the forwarding via a request for cellular call forwarding to the MSC (which must support it). 17/60-65.

The present invention, by implementing the forwarding function within the base station, does not require that the cellular system itself have a call forwarding function, nor that the base station make a call forwarding request.

2. *Akhavan* discloses a direct routing of calls when the subscriber using the mobile device changes from the home zone to the cellular system, and hence must rely on the assistance of a home and visitor location register for routing, whereas subscriber calls are all generally directed to the home area base station in the present invention, and the routing is then performed by the base station.

*Akhavan* states, "When the subscriber stations 310 roams out of the "home" zone, a radio link is established with the nearest cellular base station 304. This location is transmitted through the mobile switching center 303 and stored in the home location register 305 so that incoming calls for the subscriber 310 can be routed to the correct base station to establish cellular communication." 21/63-22/2. The information in the home location register is thus required to provide a direct routing by the cellular system when contacting the subscriber.

In contrast, in the present invention, calls directed to a subscriber are generally routed to the home area base station, not the base station indicated in a home location register.



Although applicants do not disagree with the Examiner's observation that using a base station to determine the availability of a user at that base station alone is not a novel or nonobvious application of a base station function, it is the base station's determination of non-presence in combination with its further action of rerouting of the call to the sub-communication network that represents a nonobvious advance over *Akhavan* and routine engineering practices.

**Claims 2, 10 and 16**

3. *The personal phone number (PPN) in Akhavan is forwarded to the cellular telephone system in the framework of establishing communications between a mobile device and a base station, and not in the rerouting of a call within the sub-communication network.*

*Akhavan* establishes the call forwarding at an earlier stage than the present invention.

"The key instructions that are sent constitute a request for cellular call forwarding when a base station has established communication with an appropriate subscriber hand-set or portable station." 17/44-47. "Thus, the communications from the transmitter 103 to the cellular telephone system will contain the PPN of the hand-set currently in communication with the base station 100..." 17/60-63.

Since the home base station of the present invention transmits the PPN at the time a call is generally routed to it (each and every time, after a check to see that the mobile device is not accessible by the home system), it does not require the utilization of the forwarding function of the cellular phone system as discussed above.

Applicants furthermore incorporate the arguments made under paragraphs 1 & 2 above relating to the independent claims from which each of these claims depend.

**Claims 6, 14 and 15**

4. *Akhavan does not disclose rerouting the call using the ISDN standard call deflection/forwarding.*

As discussed under paragraph 3 above, *Akhavan* discloses a cellular call forwarding of a call when a base station has established communication with an appropriate subscriber hand-set. The cellular call forwarding doesn't represent a special feature of a communication network, but indicates the forwarding of a call from the hand-set via the base station to the cellular telephone network. Contrary to the disclosure in *Akhavan*, the call deflection in claim 6 represents a special ISDN feature. In assistance with this feature, a call can be rerouted to a further terminal equipment of the same network or a different network where the destination address or telephone number must be indicated. Hence, this feature, in combination with the features of the independent claim from which this depends, are not obvious in light of *Akhavan*.

Applicants furthermore incorporate the arguments made under paragraphs 1 & 2 above relating to the independent claims from which each of these claims depend.

**Remaining claims 2-5, 7-9, 11-13 and 17-18**

Applicants rely on the above arguments related to the independent claims from which these remaining claims depend.

For all of the above reasons, Applicants respectfully request that the Examiner withdraw the obviousness rejection of the above claims.

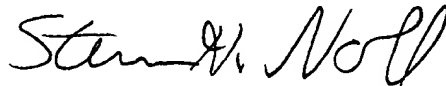
*Conclusion*

As applicants have noted above, the implementation of the switching function in the home base station as claimed in the present invention serves a much broader and functionally different role than simply the reduction of complexity and load on the MSC, and is distinguishable over the cellular system that is disclosed by *Akhavan*. The dependant claims that contain additional limitation that might be construed as obvious variations when considered alone are non-obvious when considered in combination with the limitations of the claims from which they depend.

Minor typographical corrections have been made to dependent claims 1, 10 and 15.

Inasmuch as each of the rejections have been overcome by the amendments, and all of the examiner's suggestions and requirements have been satisfied, it is respectfully requested that the present application be reconsidered, the rejections be withdrawn and that this application be passed to issue.

Respectfully submitted,



(Reg. No. 28,982)

Steven H. Noll  
Hill & Simpson  
A Professional Corporation  
85th Floor Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606  
(312) 876-0200  
Attorneys for Applicant



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/932,704	09/18/97	MORPER	H P97.1957

HILL STEADMAN & SIMPSON  
A PROFESSIONAL CORPORATION  
85TH FLOOR SEARS TOWER  
CHICAGO IL 60606

LM02/1007

EXAMINER

CRAYER, C

ART UNIT	PAPER NUMBER
----------	--------------

2744

DATE MAILED:

10/07/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/932,704

Applicant(s)

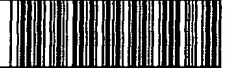
Morper

Examiner

Charles Craver

Group Art Unit

2744



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-6, 10-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan, U.S. Patent #5,673,308.

Regarding claims 1, 10 and 15, Akhavan discloses:

a method for controlling calls in a cellular network, comprising  
calling, using a telephone number, wireless terminal equipment (i.e. mobile station)  
wirelessly connected to base stations of a general (reads home) area, said base stations being  
connected to communication terminals in said network (i.e. MSC, MTSO), said mobile unit being  
additionally connected wirelessly to a sub-network of said network (abstract, column 22 lines 3-  
12 and 22-36, figures 3 and 4);  
switching calls directed to a called mobile unit to an appertaining base station in said  
general area, availability of said mobile unit being determined by said communication terminals;

and

rerouting the call, given non-availability of the called mobile unit, to the sub-communication network (column 21 line 46- column 22 line 2 and column 22 lines 37-65).

Akhavan discloses applicants invention, except that the availability of the mobile unit is determined by the base station, and is thus used in rerouting the call.

However, it was well known in the art at the time the invention was made to determine the availability of a user at the base station (i.e. via HLR, VLR) to keep the MSC from overuse, or, alternately, to incorporate an MSC into a base station so as to lower system complexity. The examiner takes official notice as such. Either option was well known, and would meet applicants limitation of using the base station to determine user availability, and further said base station would inherently be involved in the rerouting of the call in non-availability is determined. It would have been obvious to one skilled in the art to move such a function from an MSC to the base station, because, as mentioned previously, it would keep the MSC from overuse, or in the alternate, lower system complexity, and would thus be a routine engineering decision predicated on system size and ability.

Further regarding claims 2, 10 and 16,

Akhavan discloses further that the sub-communication base station can be the source of the call setup for rerouting the call using a mobile telephone number of the mobile unit (column 17 lines 35-65).

Further regarding claims 6, 14 and 15,

Akhavan further discloses that the rerouting of the call is realized using call deflection or call forwarding, an ISDN standard (column 17 lines 40-47, column 9 line 63-column 10 line 22).

Regarding claims 3, 11 and 17,

Akhavan discloses that the availability of the mobile unit is determined by the use of a paging method incorporating a base station (column 7 line 52-column 8 line 5).

Regarding claims 5 and 13,

Akhavan discloses a public switching network (PSTN) and ISDN associated with the communication networks (column 9 line 63-column 10 line 22).

4. Claims 4, 7, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan as applied to claim 1 above, and further in view of the applicant's own admission of prior art.

Regarding claims 4, 8 and 9,

Akhavan, while disclosing a call deflection method, does not disclose that the paging procedure and wireless base station-to-mobile unit connection is implemented according to a DECT or GAP or CAP standard.

The applicant admits as prior art in the background of the invention the method of using a DECT standard or a GAP or CAP standard in a wireless communication connection, which would include paging (applicant page 1 lines 1-9, page 2 lines 5-9).

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the DECT and CAP or GAP standards, taught by the applicant, into the invention of Akhavan, as it would allow the invention of Akhavan to work along with set standards.

Regarding claim 7,

Akhavan, while disclosing a call deflection method, does not disclose that the communication terminal is implemented according to one of an SO and UKO-ISDN access.

However, it is well known in the art to apply an access standard such as SO or UKO-



ISDN access to an ISDN connection in a wireless communication protocol, and the examiner takes official notice as such.

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the SO or UKO-ISDN standards, taught by the applicant, into the invention of Akhavan, as it would allow the invention of Akhavan to work along with set standards.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan as applied to claim 10 above, and further in view of the applicant's own admission of prior art.

Please see the rejection of claim 4 above.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan as applied to claim 15 above, and further in view of the applicant's own admission of prior art.

Please see the rejection of claim 4 above.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Urs et al discusses a method for connecting a mobile unit to a sub-communication network from a parent network using base stations.

Zicker et al ('259) discusses a method for using a mobile unit in connection with several base stations which are in communication with each other.

Zicker discusses a multiple mode cordless phone connected wirelessly to a main network and a sub-communication network within said main network.

D'Avello et al discusses multiple mode cordless phone which is connectable to a main network, a microcellular network and a sub-communication network within said main network.

**9. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, sixth floor (receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

C. Craver  
October 4, 1999

CC

CHARLES CRAVER  
PATENT EXAMINER

Tracy A. Legree  
TRACY A. LEGREE  
PATENT EXAMINER  
10/4/99



Dear Patent and Trademark Office Customer:

The Technical Support Staff of Technology Center 2700 has undertaken continuous quality improvement efforts to ensure that the accompanying correspondence meets high quality standards, and focuses on good customer service. It is important to us that you are satisfied with the services we provide.

If the contents of the attached correspondence has any clerical omissions, e.g., missing references or pages, illegible text, or errors, please contact Verlene Green or Earline Green, as soon as possible. We will take the appropriate action to expedite the necessary corrections.

Verlene D. Green  
Supervisory Legal Instruments Examiner  
Phone Number: (703) 305-4376

Earline Green  
Supervisory Legal Instruments Examiner  
Phone Number: (703) 305-4901

Fax No. (703) 308-9051 or (703) 308-9052

## Attention: Policy on Returning Phone Calls

A PTO-wide customer service standard is if a PTO employee being called is not available, they will return your call by the next business day, or, if you request, an alternate point of contact will be provided. Technology Center 2700 is committed to meeting this service standard. If you have called any employee in our Technology Center and have not received a return phone call within one (1) business day or have not been provided another point of contact, please contact the Technology Center at 703-306-5631. We ensure that you will receive a return phone call, from an employee with the ability to assist you, within four (4) business hours of this contact. We appreciate your help in assisting us to help you.

The employees of Technology Center 2700

# NOTICE OF DRAFTPERSON'S PATENT DRAWING REVIEW

The drawing filed (insert date) 9/18/97 are:

A.    not objected to by the Draftperson under 37 CFR 1.84 or 1.152.

B.    objected to by the Draftperson under 37 CFR 1.84 or 1.152 as indicated below. The Examiner will require submission of new, corrected drawings where necessary. Corrected drawings must be submitted according to the instructions on the back of this notice.

## 1. DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings: Black ink. Color.

   Color drawing are not acceptable until petition is granted.

Fig.(s)   

   Pencil and non black ink is not permitted. Fig(s)   

## 2. PHOTOGRAPHS. 37 CFR 1.84(b)

   Photographs are not acceptable until petition is granted,

   3 full-tone sets are required. Fig(s)   

   Photographs not properly mounted (must bristol board or photographic double-weight paper). Fig(s)   

   Poor quality (half-tone). Fig(s)   

## 3. TYPE OF PAPER. 37 CFR 1.84(e)

   Paper not flexible, strong, white and durable.

Fig.(s)   

   Erasures, alterations, overwritings, interlineations, folds, copy machine marks not acceptable. (too thin)

   Mylar, vellum paper is not acceptable (too thin).

Fig(s)   

## 4. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable sizes:

   21.0 cm by 29.7 cm (DIN size A4)

   21.6 cm by 27.9 cm (8 1/2 x 11 inches)

   All drawings sheets not the same size.

Sheet(s)   

## 5. MARGINS. 37 CFR 1.84(g): Acceptable margins:

   Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm  
SIZE: A4 Size

   Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm  
SIZE: 8 1/2 x 11

   Margins not acceptable. Fig(s)   

   Top (T)    Left (L)

   Right (R)    Bottom (B)

## 6. VIEWS. CFR 1.84(h)

REMINDER: Specification may require revision to correspond to drawing changes.

   Views connected by projection lines or lead lines.

Fig.(s)   

Partial views. 37 CFR 1.84(h)(2)

   Brackets needed to show figure as one entity.

Fig.(s)   

   Views not labeled separately or properly.

Fig.(s)   

   Enlarged view not labeled separately or properly.

Fig.(s)   

## 7. SECTIONAL VIEWS. 37 CFR 1.84(h)(3)

   Hatching not indicated for sectional portions of an object.

Fig.(s)   

   Sectional designation should be noted with Arabic or Roman numbers. Fig.(s)   

## 8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)

   Words do not appear on a horizontal, left-to-right fashion when page is either upright or turned, so that the top becomes the right side, except for graphs. Fig.(s)   

   Views not on the same plane on drawing sheet. Fig.(s)   

## 9. SCALE. 37 CFR 1.84(k)

   Scale not large enough to show mechanism with crowding when drawing is reduced in size to two-thirds in reproduction.

Fig.(s)   

## 10. CHARACTER OF LINES, NUMBERS, & LETTERS. 37 CFR 1.84(l)

   Lines, numbers & letters not uniformly thick and well defined, clean, durable and black (poor line quality).

Fig.(s)   

## 11. SHADING. 37 CFR 1.84(m)

   Solid black areas pale. Fig.(s)   

   Solid black shading not permitted. Fig.(s)   

   Shade lines, pale, rough and blurred. Fig.(s)   

## 12. NUMBERS, LETTERS, & REFERENCE CHARACTERS. 37 CFR 1.48(p)

   Numbers and reference characters not plain and legible.

Fig.(s)   

   Figure legends are poor. Fig.(s)   

   Numbers and reference characters not oriented in the same direction as the view. 37 CFR 1.84(p)(3) Fig.(s)   

   English alphabet not used. 37 CFR 1.84(p)(3) Fig.(s)   

   Numbers, letters and reference characters must be at least .32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3) Fig.(s)   

## 13. LEAD LINES. 37 CFR 1.84(q)

   Lead lines cross each other. Fig.(s)   

   Lead lines missing. Fig.(s)   

## 14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.48(t)

   Sheets not numbered consecutively, and in Arabic numerals beginning with number 1. Fig.(s)   

## 15. NUMBERING OF VIEWS. 37 CFR 1.84(u)

   Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig.(s)   

## 16. CORRECTIONS. 37 CFR 1.84(w)

   Corrections not made from PTO-948 dated   

## 17. DESIGN DRAWINGS. 37 CFR 1.152

   Surface shading shown not appropriate. Fig.(s)   

   Solid black shading not used for color contrast.

Fig.(s)   

COMMENTS

REVIEWER

Tamus

DATE

1/21/98

TELEPHONE NO.

703 305 8404

## REMINDER

Drawing changes may also require changes in the specification, e.g., if Fig. I is changed to Fig. IA, Fig. IB, Fig. IC, etc., the specification, at the Brief Description of the Drawings, must likewise be changed. Please make such changes by 37 CFR 1.312 Amendment at the time of submitting drawing changes.

## INFORMATION ON HOW TO EFFECT DRAWING CHANGES

### 1. Correction of Informalities--37 CFR 1.85

File new drawings with the changes incorporated therein. The application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call if the Office is unable to match the drawings to the proper application, should be placed on the back of each sheet of drawings in accordance with 37 CFR 1.84(c). Applicant may delay filing of the new drawings until receipt of the Notice of Allowability (PTOL-37). Extensions of time may be obtained under the provisions of 37 CFR 1.136. The drawing should be filed as a separate paper with a transmittal letter addressed to the Drawing Review Branch.

### 2. Timing of Corrections

Applicant is required to submit **acceptable** corrected drawings within the three-month shortened statutory period set in the Notice of Allowability (PTOL-37). If a correction is determined to be unacceptable by the Office, applicant must arrange to have acceptable correction resubmitted within the original three-month period to avoid the necessity of obtaining an extension of time and paying the extension fee. Therefore, applicant should file corrected drawings as soon as possible.

Failure to take corrective action within set (or extended) period will result in **ABANDONMENT** of the Application.

### 3. Corrections other than Informalities Noted by the Drawing Review Branch on the Form PTO 948

All changes to the drawings, other than informalities noted by the Drawing Review Branch, **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Notice of References Cited**Application No.  
**08/932,704**

Applicant(s)

**Morper**Examiner  
**Charles Craver**Group Art Unit  
**2744**

Page 1 of 1

**U.S. PATENT DOCUMENTS**

	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	5,887,259	3/1999	Zicker et al	455	434
B	5,901,357	5/1999	D'Avello et al	455	454
C	5,774,805	1/1998	Zicker	455	426
D	5,711,011	1/1998	Urs et al	455	520
E					
F					
G					
H					
I					
J					
K					
L					
M					

**FOREIGN PATENT DOCUMENTS**

	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
N						
O						
P						
Q						
R						
S						
T						

**NON-PATENT DOCUMENTS**

	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
U		
V		
W		
X		

DN. COMMISSIONER OF PATENTS & TRADEMARKS  
WASHINGTON, D.C. 20231



SIR: PLEASE APPLY A RECEIPT STAMP HERETO AND MAIL TO  
ACKNOWLEDGE RECEIPT OF THE ATTACHED:

Response to Office Action,  
form U10 in duplicate

Hans-Jochen Morper

APPLICANT

TYPE OF DOCUMENT(S)

July <sup>29</sup>~~28~~, 1999

MAILING DATE

08/932,704 P97,1957

REFERENCE NUMBER

491/1078 due: July 29, 1999

**HILL & SIMPSON**  
A PROFESSIONAL CORPORATION

Form 20R

CHICAGO OFFICE  
TELEPHONE (312) 876-0200  
TELECOPIER (312) 876-0898

**HILL & SIMPSON**  
A PROFESSIONAL CORPORATION  
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In re application of: HANS-JOCHEN MORPER

DOCKET NO: P97,1957

Serial No: 08/932,704

GROUP ART UNIT: 2744

Filed: SEPTEMBER 18, 1997

EXAMINER: C. CRAVER

For: **METHOD FOR CALL CONTROL OF COMMUNICATION TERMINAL  
EQUIPMENT WIRELESSLY CONNECTED TO COMMUNICATION  
NETWORKS**

Assistant Commissioner for Patents,  
Washington, D.C. 20231

Transmitted herewith is an amendment in the above-identified application.

☒ No additional fee is required.

The fee has been calculated as shown below.

CLAIMS AS AMENDED						
	(2) CLAIMS REMAINING AFTER AMENDMENT		(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	* 18	MINUS	** 20	-0-	( ) X 9.00 ( ) X 18.00	
INDEP. CLAIMS	* 03	MINUS	** 03	-0-	( ) X 39.00 ( ) X 78.00	
Application amended to contain any multiple dependent claims not previously paid for.				( ) YES (X) NO	( ) \$130.00 ( ) \$260.00 ONE TIME	
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					NONE	

\* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20 write "20" in this space.

- ☐ Applicant petitions the Commissioner of Patents and Trademarks to extend this time for response to the Office Action dated \_\_\_\_\_ for \_\_\_\_\_ month so that the period for response is extended to \_\_\_\_\_.
- ☐ A check in the amount of \$ \_\_\_\_\_ is attached to cover the cost of the extension.
- ☐ A check for \$ \_\_\_\_\_ is enclosed to cover the cost of \_\_\_\_\_ extra independent claim.
- ☐ A check for \$ \_\_\_\_\_ accompanying IDS under 37 CFR 1.97(c) is attached.
- ☐ A check for \$ \_\_\_\_\_ and Petition for Consideration of IDS under 37 CFR 1.97(d) is attached.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. 08-2290. A duplicate of this sheet is enclosed.
- When phoning regarding this application, please call (312) 876-0200 - Ext. 3078.

BY John R. Garrett (Reg. No. 27,888)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on July 28, 1999.

29

John R. Garrett

Attorney for Applicants



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT(S): HANS-JOCHEN MORPER DOCKET NO: P97,1957  
SERIAL NO: 08/932,704 ART UNIT: 2744  
FILING DATE: SEPTEMBER 18, 1997 EXAMINER: C. CRAVER  
INVENTION: **METHOD FOR CALL CONTROL OF COMMUNICATION  
TERMINAL EQUIPMENT WIRELESSLY CONNECTED TO  
COMMUNICATION NETWORKS**

Assistant Commissioner for Patents,  
Washington, D.C. 20231

**RESPONSE**

Sir:

This communication is in response to the Office Action of April 29, 1999. In the Office Action the Examiner rejected claims 1-3, 5, 6, 10, 11 and 13-17 under 35 U.S.C. §102 as being anticipated by Akhavan (U.S. Patent 5,673,308). The Examiner also rejected claims 4, 7, 8 and 9 under 35 U.S.C. §103 as being unpatentable over Akhavan and further in view of the admitted prior art.

In the present application claims 1, 10 and 15 are independent claims. The claimed invention is a method for controlling calls in a communication network. The first step of the method is calling, using a telephone number, wireless communication terminal equipment that is wirelessly connected to base stations of a home area. The base stations are connected to communication terminals of the communication network. The wireless communication terminal equipment is additionally wirelessly connected to a sub-communication network of a communication network. In a second step calls directed to a called wireless communication terminal equipment are switched to an associated base station in a home area using a communication network. Availability of the called wireless communication terminal equipment is determined by the associated base station in the home area. In a third step, the call is re-routed, given non-availability of the called wireless communication terminal equipment, to the sub-communication network using the associated base station. Claims 10 and 15 add

further limiting features.

The Examiner has rejected each of the independent claims as being anticipated by Akhavan.

Akhavan discloses a method for controlling calls. The method consists of calling, using a telephone network, connecting wireless equipment wirelessly to base stations of a general area, wherein the base station is connected to communication terminals of a network and the mobile unit is additionally connected wirelessly to a sub-network of the network. Furthermore, Akhavan discloses a routing of calls directed to a subscriber using a home location register and a visitor location register. It is arranged in a cellular telephone system of a public switched telephone network (see column 21, lines 61 through column 22, line 2, as well as, column 22, lines 47-53). This means that an incoming call is routed directly to the subscriber when the subscriber has changed from the home zone to the cellular telephone system.

In the method as set forth in independent claims 1, 10 and 15 of the present application, a call that is directed to a subscriber is generally routed to an associated base station in the home area. This is contrary to the teachings of Akhavan. Utilizing the associated base station the availability of the called wireless communication terminal in the home area is determined. If the terminal is not available the call is re-routed to the sub-communication network. This means that the essential steps of the method of the present invention is not disclosed in Akhavan. Furthermore, one skilled in the art would not be lead by the disclosure in Akhavan to provide the method according to the present invention because in Akhavan there is no teaching or suggestion for a general routing of calls directed to a subscriber to the associated base station of a home area independent of the area in which the general subscriber terminal can be reached, that is, the home area or sub-communication network area. Therefore, the method of the present invention is not anticipated nor disclosed by Akhavan.

For the reasons set forth above, the rejection of the independent claims under 35 U.S.C. §102 has been overcome, and the Examiner is respectfully requested to reconsider the rejection of the independent claims under 35 U.S.C. §102.

Since claims 2, 3, 5, 6, 11, 13, 14, 16 and 17 are dependent claims that include all of the limitations of the independent claims upon which they depend, these claims are also not anticipated nor unpatentable over the cited prior art. Therefore, the Examiner is respectfully requested to reconsider the rejection of all claims under 35 U.S.C. §102. The claims that were rejected under 35 U.S.C. §103 are also dependent claims and therefore for the reasons set forth above, these claims are also not anticipated nor obvious in view of the cited prior art. Therefore the Examiner is respectfully requested to reconsider the rejection of the claims under 35 U.S.C. §103.

To the extent that the independent claims herein and the cited prior art have any elements or steps in common, those elements or steps in the prior art are not arranged and operating in the same manner as in the independent claims. Therefore, the claims are not anticipated under the provisions of Section 102, which requires an element-by-element correspondence between a claim and the cited reference. Such correspondence is not present between the independent claims and the cited prior art.

In view of the fundamentally different theories of operation between the claimed subject matter and the cited prior art, the claims would not have been obvious to a person of ordinary skill in the relevant art. Because of such differences in structure and operation, there is no inducement or teaching for such a person to rearrange the cited prior art so as to arrive at a system comparable to the claimed system, absent reading Applicant's disclosure. Even if such a rearrangement were undertaken for reasons unknown to the Applicant, this rearrangement would constitute a substantial redesign rather than an obvious modification of the cited prior art, and as such is not a proper basis for rejection under Section 103.

Applicant notes the Notice of Draftsperson's Patent Drawing Review in which the drawings were objected to. Upon allowance of the present application Applicant will provide formal drawings. The prior art made of record and not relied upon is considered to be of general interest only.

This application is believed to be in condition for allowance and such action at an early date is earnestly solicited.

Respectfully submitted,



(Reg. No. 27,888)

John R. Garrett  
Hill & Simpson  
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85th Floor Sears Tower  
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(312) 876-0200, Ext. 3078  
Attorneys for Applicant

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on July 28, 1999.



Attorney for Applicants



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/932,704 09/18/97 MORPER

H P97.1957

EXAMINER

LM02/0429

HILL STEADMAN & SIMPSON  
A PROFESSIONAL CORPORATION  
85TH FLOOR SEARS TOWER  
CHICAGO IL 60606

CRAVER, C

ART UNIT

PAPER NUMBER

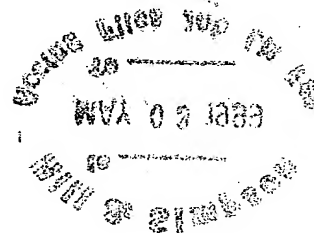
2744

DATE MAILED:

04/29/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**



# Office Action Summary

Application No.  
08/932,704

Applicant(s)

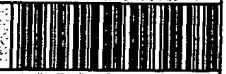
Morper

Examiner

Charles Craver

Group Art Unit

2744



- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-18 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_
- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2744

### **DETAILED ACTION**

#### ***Priority***

1. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

#### ***Specification***

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor grammatical errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Art Unit: 2744

4. Claims 1-3, 5, 6, 10, 11, and 13-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Akhavan, U.S. Patent #5,673,308.

Regarding claim 1, Akhavan discloses:

a method for controlling calls in a cellular network, comprising

calling, using a telephone number, wireless terminal equipment (i.e. mobile station) wirelessly connected to base stations of a general (reads home) area, said base stations being connected to communication terminals in said network (i.e. MSC, MTSO), said mobile unit being additionally connected wirelessly to a sub-network of said network (abstract, column 22 lines 3-12 and 22-36, figures 3 and 4);

switching calls directed to a called mobile unit to an appertaining base station in said general area, availability of said mobile unit being determined by said base station; and

rerouting the call, given non-availability of the called mobile unit, to the sub-communication network (column 21 line 46- column 22 line 2 and column 22 lines 37-65), inherently using said base station.

Regarding claim 2,

Akhavan discloses further that the sub-communication base station can be the source of the call setup for rerouting the call using a mobile telephone number of the mobile unit (column 17 lines 35-65).

Regarding claim 3,



Art Unit: 2744

Akhavan discloses that the availability of the mobile unit is determined by the use of a paging method incorporating a base station (column 7 line 52-column 8 line 5).

Regarding claim 5,

Akhavan discloses a public switching network (PSTN) and ISDN associated with the communication networks (column 9 line 63-column 10 line 22).

Regarding claim 6,

Akhavan discloses repeatedly that the rerouting of the call is realized using call deflection or call forwarding, an ISDN standard (column 17 lines 40-47, column 9 line 63-column 10 line 22).

Regarding claim 10, Akhavan discloses:

a method for controlling calls in a cellular network, comprising  
calling, using a telephone number, wireless terminal equipment (i.e. mobile station)  
wirelessly connected to base stations of a general (reads home) area, said base stations being  
connected to communication terminals in said network (i.e. MSC, MTSO), said mobile unit being  
additionally connected wirelessly to a sub-network of said network (abstract, column 22 lines 3-  
12 and 22-36, figures 3 and 4);

switching calls directed to a called mobile unit to an appertaining base station in said  
general area, availability of said mobile unit being determined by said base station; and

Art Unit: 2744

rerouting the call, given non-availability of the called mobile unit, to the sub-communication network (column 21 line 46- column 22 line 2 and column 22 lines 37-65), inherently using said base station.

Akhavan discloses further that the sub-communication base station can be the source of the call setup for rerouting the call using a mobile telephone number of the mobile unit (column 17 lines 35-65).

Regarding claim 11,

Akhavan discloses that the availability of the mobile unit is determined by the use of a paging method incorporating a base station (column 7 line 52-column 8 line 5).

Regarding claim 13,

Akhavan discloses a public switching network (PSTN) and ISDN associated with the communication networks (column 9 line 63-column 10 line 22).

Regarding claim 14,

Akhavan discloses repeatedly that the rerouting of the call is realized using call deflection or call forwarding, an ISDN standard (column 17 lines 40-47, column 9 line 63-column 10 line 22).

Regarding claim 15, Akhavan discloses:

a method for controlling calls in a cellular network, comprising  
calling, using a telephone number, wireless terminal equipment (i.e. mobile station)  
wirelessly connected to base stations of a general (reads home) area, said base stations being

Art Unit: 2744

connected to communication terminals in said network (i.e. MSC, MTSO), said mobile unit being additionally connected wirelessly to a sub-network of said network (abstract, column 22 lines 3-12 and 22-36, figures 3 and 4);

switching calls directed to a called mobile unit to an appertaining base station in said general area, availability of said mobile unit being determined by said base station; and

rerouting the call, given non-availability of the called mobile unit, to the sub-communication network (column 21 line 46- column 22 line 2 and column 22 lines 37-65), inherently using said base station.

Akhavan further discloses that the rerouting of the call is realized using call deflection or call forwarding, an ISDN standard (column 17 lines 40-47, column 9 line 63-column 10 line 22).

Regarding claim 16,

Akhavan discloses further that the sub-communication base station can be the source of the call setup for rerouting the call using a mobile telephone number of the mobile unit (column 17 lines 35-65).

Regarding claim 17,

Akhavan discloses that the availability of the mobile unit is determined by the use of a paging method incorporating a base station (column 7 line 52-column 8 line 5).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2744

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 7, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Akhavan as applied to claim 1 above, and further in view of the applicant's own admission of prior art.

Regarding claims 4, 8 and 9,

Akhavan, while disclosing a call deflection method, does not disclose that the paging procedure and wireless base station-to-mobile unit connection is implemented according to a DECT or GAP or CAP standard.

The applicant admits as prior art in the background of the invention the method of using a DECT standard or a GAP or CAP standard in a wireless communication connection, which would include paging (applicant page 1 lines 1-9, page 2 lines 5-9).

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the DECT and CAP or GAP standards, taught by the applicant, into the invention of Akhavan, as it would allow the invention of Akhavan to work along with set standards.

Regarding claim 7,

Akhavan, while disclosing a call deflection method, does not disclose that the communication terminal is implemented according to one of an SO and UKO-ISDN access.

Art Unit: 2744

However, it is well known in the art to apply an access standard such as SO or UKO-ISDN access to an ISDN connection in a wireless communication protocol, and the examiner takes official notice as such.

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the SO or UKO-ISDN standards, taught by the applicant, into the invention of Akhavan, as it would allow the invention of Akhavan to work along with set standards.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan as applied to claim 10 above, and further in view of the applicant's own admission of prior art.

Akhavan, while disclosing a call deflection method, does not disclose that the paging procedure and wireless base station-to-mobile unit connection is implemented according to a DECT standard.

The applicant admits as prior art in the background of the invention the method of using a DECT standard in a wireless communication connection, which would include paging (applicant page 1 lines 1-9).

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the DECT standard taught by the applicant, into the invention of Akhavan, as it would allow the invention of Akhavan to work along with set standards.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akhavan as applied to claim 15 above, and further in view of the applicant's own admission of prior art.

Art Unit: 2744

Akhavan, while disclosing a call deflection method, does not disclose that the paging procedure and wireless base station-to-mobile unit connection is implemented according to a DECT standard.

The applicant admits as prior art in the background of the invention the method of using a DECT standard in a wireless communication connection, which would include paging (applicant page 1 lines 1-9).

It would have been obvious to one skilled in the art at the time the invention was made to incorporate the DECT standard taught by the applicant, into the invention of Akhavan, as it would allow the invention of Akhavan to work along with set standards.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hjern et al discusses a method for transfer of calls between a cellular network and a home radio base station.

Amin et al discusses service transfer, including call transfer, between a personal radio base station and a cellular network.

Cheng et al discusses a personal base station in communication with a PSTN and outside of a cellular network.

Art Unit: 2744

Oksanen et al discusses call transfer between public cellular systems and private sub-communication personal base stations.

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Application/Control Number: 08/932704

Page 11

Art Unit: 2744

C. Craver

April 25, 1999

*CPC*



DWAYNE D. BOST  
SUPERVISORY PATENT EXAMINER  
GROUP 2700





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Verlene D. Green

Supervisory Legal Instruments Examiner

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The drawing filed (insert date) 9/18/97 are:

- A. ✓ not objected to by the Draftperson under 37 CFR 1.84 or 1.152.
- B. ✓ objected to by the Draftperson under 37 CFR 1.84 or 1.152 as indicated below. The Examiner will require submission of new, corrected drawings where necessary. Corrected drawings must be submitted according to the instructions on the back of this notice.

1. DRAWINGS. 37 CFR 1.84(a) Acceptable categories of drawings:

Black ink. Color:

Color drawing are not acceptable until petition is granted.

Fig(s)

Pencil and non black ink is not permitted. Fig(s)

2. PHOTOGRAPHS. 37 CFR 1.84(b)

Photographs are not acceptable until petition is granted.

3 full-tone sets are required. Fig(s)

Photographs not properly mounted (must be on board or

photographic double-weight paper). Fig(s)

Poor quality (half-tone). Fig(s)

3. TYPE OF PAPER. 37 CFR 1.84(e)

Paper not flexible, strong, white and durable:

Fig(s)

Erasures, alterations, overwritings, interlineations,

fold, copy machine marks not acceptable. (too thin)

Mylar, vellum paper is not acceptable (too thin)

Fig(s)

4. SIZE OF PAPER. 37 CFR 1.84(f) Acceptable sizes:

X 21.0 cm by 29.7 cm (DIN size A4)

21.6 cm by 27.9 cm (8 1/2 x 11 inches)

All drawings sheets not the same size.

Sheet(s)

5. MARGINS. 37 CFR 1.84(g) Acceptable margins:

X Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm

SIZE: A4 Size

Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm

SIZE: 8 1/2 x 11

X Margins not acceptable. Fig(s)

Top (T) Left (L)

Right (R) Bottom (B)

6. VIEWS. 37 CFR 1.84(h)

REMINDER: Specification may require revision to correspond to drawing changes.

Views connected by projection lines or lead lines.

Fig(s)

Partial views. 37 CFR 1.84(h)(2)

Brackets needed to show figure as one entity.

Fig(s)

Views not labeled separately or properly.

Fig(s)

Enlarged view not labeled separately or properly.

Fig(s)

7. SECTIONAL VIEWS. 37 CFR 1.84(h)(3)

Hatching not indicated for sectional portions of an object.

Fig(s)

Sectional designation should be noted with Arabic or

Roman numbers. Fig(s)

8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)

Words do not appear on a horizontal, left-to-right fashion when page is either upright or turned, so that the top becomes the right side, except for graphs. Fig(s)

Views not on the same plane on drawing sheet. Fig(s)

9. SCALE. 37 CFR 1.84(k)

Scale not large enough to show mechanism with crowding when drawing is reduced in size to two-thirds in reproduction.

Fig(s)

10. CHARACTER OF LINES, NUMBERS, & LETTERS. 37 CFR 1.84(l)

Lines, numbers & letters not uniformly thick and well defined, clean, durable and black (poor line quality).

Fig(s)

11. SHADING. 37 CFR 1.84(m)

Solid black areas pale. Fig(s)

Solid black shading not permitted. Fig(s)

Shade lines, pale, rough and blurred. Fig(s)

12. NUMBERS, LETTERS, & REFERENCE CHARACTERS. 37 CFR 1.84(p)

Numbers and reference characters not plain and legible.

Fig(s)

Figure legends are poor. Fig(s)

Numbers and reference characters not oriented in the same

direction as the view. 37 CFR 1.84(p)(3) Fig(s)

English alphabet not used. 37 CFR 1.84(p)(3) Fig(s)

Numbers, letters and reference characters must be at least

3/32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3) Fig(s)

13. LEAD LINES. 37 CFR 1.84(q)

Lead lines cross each other. Fig(s)

Lead lines missing. Fig(s)

14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.48(i)

Sheets not numbered consecutively, and in Arabic numerals

beginning with number 1. Fig(s)

15. NUMBERING OF VIEWS. 37 CFR 1.84(u)

Views not numbered consecutively, and in Arabic numerals,

beginning with number 1. Fig(s)

16. CORRECTIONS. 37 CFR 1.84(w)

Corrections not made from PTO-948 dated

17. DESIGN DRAWINGS. 37 CFR 1.152

Surface shading shown not appropriate. Fig(s)

Solid black shading not used for color contrast.

Fig(s)

COMMENTS

**Notice of References Cited**Application No.  
08/932,704

Applicant(s)

Morper

Examiner  
Charles CraverGroup Art Unit  
2744

Page 1 of 1

**U.S. PATENT DOCUMENTS**

	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	5,673,308	9/1997	Akhavan	455	461
B	5,854,977	12/1998	Oksanen et al	455	417
C	5,845,207	12/1998	Amin et al	455	414
D	5,873,033	2/1999	Hjern et al	455	417
E	5,848,098	12/1998	Cheng et al	375	220
F					
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**FOREIGN PATENT DOCUMENTS**

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**NON-PATENT DOCUMENTS**

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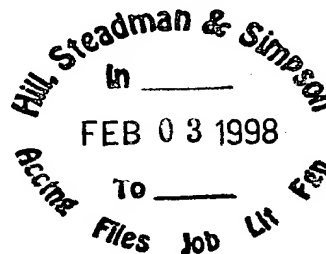
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APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTORNEY DOCKET NO.	DRWGS	TOT CL	IND CL
08/932,704	09/18/97	2744	\$770.00	P97.1957	1	18	3

HILL STEADMAN & SIMPSON  
A PROFESSIONAL CORPORATION  
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CHICAGO IL 60606



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Applicant(s)

HANS-JOCHEN MORPER, ERDWEG, FED REP GERMANY.

FOREIGN/PCT APPLICATIONS-FED REP GERMANY

19639608.5

09/26/96

TITLE

METHOD FOR CALL CONTROL OF COMMUNICATION TERMINAL EQUIPMENT  
WIRELESSLY CONNECTED TO COMMUNICATION NETWORKS

PRELIMINARY CLASS: 455



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RECORDATION DATE: 09/18/1997

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BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:  
MORPER, HANS-JOCHEN

DOC DATE: 09/11/1997

ASSIGNEE:  
SIEMENS AKTIENGESELLSCHAFT  
WITTELSBACHERPLATZ 2  
8000 MUENCHEN, FED REP GERMANY

SERIAL NUMBER: 08932704  
PATENT NUMBER:

FILING DATE:  
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A. Patent Application No.(s)

B. Patent No.(s)

P97,1957

08932704

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Hill, Steadman &amp; Simpson, P.C.

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233 S. Wacker Drive  
Chicago, IL 60606

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1

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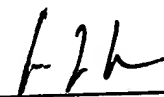
### **METHOD FOR CALL CONTROL OF COMMUNICATION TERMINAL EQUIPMENT WIRELESSLY CONNECTED TO COMMUNICATION NETWORKS**

disclosed in an application for Letters Patent of the United States, prepared by the firm of Hill, Steadman & Simpson, A Professional Corporation of Chicago, Illinois, and executed of even date herewith, said application being identified in the office records of said firm as Case No. P-97,1957, and in our own records as Case No. GR96P2259US, and in and to the United States Letters Patent therefor, when issued, together with all improvements thereon and betterments thereof, all divisions, continuations and reissues thereof and substitutions of or for said application, and all rights and privileges under the Letters Patent that may be granted therefor, including the right to claim the benefit of an earlier filing date for the same invention in a foreign country.

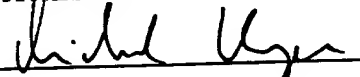
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DATE: 9/11/92

  
Hans-Jochen Morper

WITNESSES:

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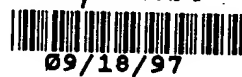
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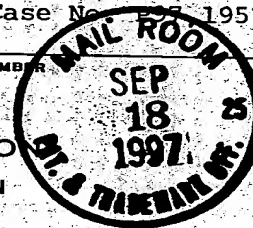
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**SPECIFICATION**

**TITLE**

**METHOD FOR CALL CONTROL OF COMMUNICATION  
TERMINAL EQUIPMENT WIRELESSLY CONNECTED  
TO COMMUNICATION NETWORKS**

**BACKGROUND OF THE INVENTION**

Wireless communication terminal equipment (also known in the technical field as "cordless" or as cordless terminal equipment) that are wirelessly connected to base stations arranged in the home area are utilized in home areas or, respectively, residential areas. The air interface is thereby realized according to the DECT standard (Digital Enhanced Cordless Telecommunications) further standards such as, for example, the GAP standard (Generic Access Profile) are provided for future wireless communication terminal equipment and base stations, whereby these further standards are based on the DECT standard and respectively provide additional application-specific functions. Advantageously, the base stations are connected via an ISDN basic access to an ISDN communication network, whereby the ISDN basic access comprises two message channels with a bandwidth of 64 kbit/s for two connections for a data or voice information communication and one signaling channel for the communication of signaling information. The wireless communication terminal equipment are thereby called with a telephone number of the public ISDN communication network, whereby a call is switched to the appertaining base station or, respectively, to the wireless communication terminal equipment.

Further, sub-communication networks or, respectively, offering networks wherein wireless communication terminal equipment are wirelessly or, respectively, cordlessly connected to base stations are planned for communication networks, particularly public ISDN communication networks. The air interface of the wireless connections is likewise realized according to the DECT standard. The wireless communication terminal equipment as well as the base stations are realized according to the GAP standard or a CAP standard (CTM (cordless terminal mobility) access profile) currently being standardized, whereby these standards are based on the DECT standard for the air interface. Special mobile telephone numbers with whose assistance connections can be set up from the ISDN communication network to the wireless communication terminal equipment can be provided for such wireless communication terminal equipment. A call with, for example, a mobile telephone number, initiated in the public communication network is switched via the corresponding offering network or, respectively, the base station thereof involved, being switched to the wireless communication terminal equipment identified by the mobile telephone number. The wireless communication terminal equipment thereby represents a communication terminal equipment of the public communication network, particularly of a public ISDN communication network.

It is also provided that a wireless communication terminal equipment is employable both in the home region as well as in the public communication network, whereby wireless communication terminal equipment are multiply present in the home region and a use in the public communication network represents an advantageous

expansion. Since the home at the public area can overlap in view of the radio areas, the wireless communication terminal equipment will often be located in two areas in which they can be reached or, respectively, from which connections can be set up into the respective areas.

### SUMMARY OF THE INVENTION

It is an object of the present invention to provide a call controller or, respectively, switching-oriented controller of calls that is simple to realize for an additional use of wireless communication terminal equipment in public communication networks.

An important aspect of the inventive method is that calls directed to a wireless communication terminal equipment are switched (using the communication network) to the appertaining base station in the home area and the latter determines the availability of the called wireless communication terminal equipment. Given a non-reachability of the called wireless communication terminal equipment, the call is rerouted to the sub-communication network or, respectively, offering network using the appertaining base station. Consequently, a determination is first made with the inventive method as to whether the respective wireless communication terminal equipment can be reached in the "cost-beneficial" home area and the call is rerouted onto the public offering network

on ~~only~~ given non-availability. In the sub-communication network or, respectively, offering network, a call setup for the rerouted call is initiated using the mobile telephone number of the respective wireless communication terminal equipment, being initiated to the respective wireless communication terminal equipment. As a result of the inventive method, the additional use of wireless communication terminal equipment designed for

9/11/97  
f-f-h

the home area is possible in the existing communication networks with the fewest modifications. At the same time, this means a low outlay for the implementation of the inventive method.

The availability of the wireless communication terminal equipment is advantageously determined using a paging method provided in the base station BS-H of the home area H. Such paging methods have already been frequently realized in wireless connections and can be advantageously co-employed without modifications, whereby the paging method is advantageously implemented according to the known DECT standard.

Advantageously, the communication network represents a public ISDN communication network. Given an ISDN communication network, the rerouting of the call is realized <sup>by</sup> the ISDN performance feature of "call deflection". By employing this ISDN performance feature of "call deflection" or call rerouting, the implementation outlay of the inventive method is further reduced. Given an implementation of the inventive method in an ISDN communication network, the communication terminals are advantageously realized by a So or UKO-ISDN basic access (SO). 9/11/97  
p.h.L

According to further advantageous development of the inventive method, the wireless connection of wireless communication terminal equipment to the base stations in the home area is realized according to the DECT or GAP~~T~~ standard and the wireless connection of wireless communication terminal equipment in the offering network (that is, in the public communication network) is realized according to the DECT or CAP standard. 9/11/97  
p.h.L

### BRIEF DESCRIPTION OF THE DRAWINGS

The features of the present invention which are believed to be novel, are set forth with particularity in the appended claims. The invention, together with further objects and advantages, may best be understood by reference to the following description taken in conjunction with the accompanying drawing, in which:

The single Figure depicts a block circuit diagram of the present invention.

### DESCRIPTION OF THE PREFERRED EMBODIMENTS

The single Figure shows a communication network KN (indicated by dot-dash lines) that is formed by a sub-communication network, particularly an offering network ACCESS and a base station BS-H of a home area H (indicated by dot-dash lines). The communication network KN is advantageously realized by an ISDN communication network ISDN. An ISDN basic access SO, UKO of the ISDN communication network ISDN is provided for the connection of the base station BS-H in the home area. The ISDN basic access SO, UKO has two message channels B, each having a respective bit rate of 64 kbit/s, and a signaling channel D, having a bit rate of 16 kbit/s.

A traffic-concentrating means RDU <sup>(Radio Distribution Unit)</sup> is connected via a further terminal of the <sup>9/11/92</sup> ISDN communication network ISDN that, for example, is realized by a V.5 interface. This means RDU is connected to base stations BS of the offering network ACCESS. Both the radio areas of these base stations BS as well as those of the further traffic-concentrating means RDU and the appertaining trunk lines (not shown) represent the offering network ACCESS. Both the ISDN communication network ISDN as well as the offering network ACCESS represent public communication networks that can also be

represented by a single ISDN communication network in which uniform telephone numbers are provided for wire-bound and wireless communication terminal equipment. Alternatively, these publicly accessible communication networks can also be installed and operated by private operators.

Wireless communication terminal equipment KE are connected to the base stations BS-H, BS both in the offering network ACCESS as well as in the home area H. The air interface is thereby realized according to the known DECT standard. The wireless communication terminal equipment KE and the base stations BS-H can be fashioned according to the GAP standard (generic access profile) in the residential/private domain. <sup>3/11/97</sup>  
In the offering network ACCESS, the base stations BS and the wireless communication terminal equipment KE can be alternatively realized by a CAP standard, that is, a CTM (cordless terminal mobility) access profile.

The ISDN basic access SO, UKO or, respectively, the base station BS-H and the wireless communication terminal equipment KE connected thereto can be reached via a telephone number rn, whereby the telephone number rn represents an ISDN communication network-specific telephone number rn. The wireless communication terminal equipment KE wirelessly connected in the home area H are subscribed in the respective base station BS-H and are utilized for a call setup.

A call setup to the wireless communication terminal equipment KE of the offering network ACCESS is implemented using a mobile telephone number mrn. This mobile telephone number mrn differs from the telephone number rn of the ISDN communication network ISDN and <sup>may be</sup> is treated differently in terms of fee scheduling. The

<sup>3/11/97</sup>  
F/L

9/10/92  
F/L

mobile telephone number mrn need not be known to the subscriber or, respectively, communication terminal equipment KE since the call (ar) in the inventive method is always switched first to the base station BS-H in the home area H. Given uniform telephone numbers rn, the mobile telephone number mrn can also be potentially ~~unknown to the user~~ <sup>eliminated</sup> and a call setup to the offering network ACCESS can ensue with the communication network-specific telephone number rn.

Let it be assumed for the exemplary embodiment that a wireless communication terminal equipment KE of the home area H can also be used in the offering network ACCESS. This means an additional, advantageous use of the wireless communication terminal equipment KE already present in the home area H. Inventively, a call ar directed to a wireless communication terminal equipment KE is first fundamentally switched to the base station BS-H of the home area H, whereby subscription or, respectively, a utilization permit is provided for the called wireless communication terminal equipment KE both for the home area H as well as for the offering network ACCESS or, respectively, the ISDN communication network ISDN. Given a call ar incoming in the base station BS-H, a check is made using the "wireless" paging method defined in the DECT standard (indicated in the single Figure by the designation PV) to determine if the called wireless communication terminal KE can be reached. When the called wireless communication terminal equipment can be reached, the incoming call ar is switched to the wireless communication terminal equipment KE.

Given a finding of non-availability of the called wireless communication terminal equipment KE, the base station BS-H initiates a rerouting of the incoming call ar to the

offering network ACCESS. This rerouting is meaningful since the called wireless communication terminal KE could be located in the radio coverage area of the base stations BS of the offering network ACCESS. Instead of the telephone number rn of the ISDN communication network ISDN, the mobile telephone number mrn (insofar as it is provided) is inserted into the rerouted call ar'. In the offering network ACCESS, a call setup to the called wireless communication terminal equipment KE is initiated via the appertaining base station BS. If non-availability of the called wireless communication terminal equipment KE is also found in this call setup, the call (AR) is rejected. A non-availability of the wireless communication terminal equipment KE is present, for example, when this is turned off, that is, when it is in the currentless condition.

The inventive method defines an unambiguous procedure in order to establish connections, that is, <sup>calls</sup> ~~call~~ ar, that are directed to a wireless communication terminal equipment KE that is subscribed or, respectively, authorized both in the home area H as well as in the offering network ACCESS of the ISDN communication network ISDN, whereby the existing communication network is not influenced or, respectively, modified. The inventive method, consequently, can be implemented with the least outlay in the already existing communication network KN, particularly the ISDN communication network ISDN and the home area H, whereby existing ISDN and DECT performance features such as the paging method and "call deflection" are used for the rerouting of calls (ar) in the base station BS-H in the home area H. The implementation outlay is additionally reduced as a result thereof.

3/11/87  
KFL  
3/11/87  
KFL



The invention is not limited to the particular details of the method depicted and other modifications and applications are contemplated. Certain other changes may be made in the above described method without departing from the true spirit and scope of the invention herein involved. It is intended, therefore, that the subject matter in the above depiction shall be interpreted as illustrative and not in a limiting sense.

**WHAT IS CLAIMED IS:**

1. A method for controlling calls in a communication network, calling, using a telephone number, wireless communication terminal equipment wirelessly connected to base stations of a home area, the base stations being connected to communication terminals of the communication network, and the wireless communication terminal equipment being additionally wirelessly connected to a sub-communication network of the communication network;

switching calls directed to a called wireless communication terminal equipment to an appertaining base station in the home area using the communication network, availability of the called wireless communication terminal equipment being determined said appertaining base station in the home area; and

rerouting the call, given non-availability of the called wireless communication terminal equipment, to the sub-communication network using the appertaining base station.

2. The method according to claim 1, wherein a call setup for a rerouted call is initiated in the sub-communication network using a mobile telephone number of the called wireless communication terminal equipment, the rerouted call being initiated for the respective wireless communication terminal equipment.

3. The method according to claim 1, wherein availability of the called wireless communication terminal equipment is determined using a paging procedure provided in the base station of the home area.

4. The method according to claim 3, wherein the paging procedure is implemented according to a DECT standard.

5. The method according to claim 1, wherein at least one of the communication network and the sub-communication network is a public ISDN communication network.

6. The method according to claim 5, wherein the rerouting of the call is realized using an ISDN performance feature of "call deflection".

7. The method according to claim 5, wherein the communication terminal is realized by one of an SO access and UKO-ISDN basic access.

8. The method according to claim 1, wherein wireless connection of wireless communication terminal equipment to the base stations in the home area is realized according to one of DECT standard.

9. The method according to claim 1, wherein wireless connection of wireless communication terminal equipment to basic stations is realized according to one of a DECT standard and a CAP standard.

5/11/92  
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10. A method for controlling calls in a communication network,  
calling, using a telephone number, wireless communication terminal equipment wirelessly connected to base stations of a home area, the base stations being connected to communication terminals of the communication network, and the wireless communication terminal equipment being additionally wirelessly connected to a sub-communication network of the communication network;

switching calls directed to a called wireless communication terminal equipment to an appertaining base station in the home area using the communication network, availability of the called wireless communication terminal equipment being determined said appertaining base station in the home area;

rerouting the call, given non-availability of the called wireless communication terminal equipment, to the sub-communication network using the appertaining base station; and

initiating a call setup for a rerouted call in the sub-communication network using a mobile telephone number of the called wireless communication terminal equipment, the rerouted call being initiated for the respective wireless communication terminal equipment.

11. The method according to claim 10, wherein availability of the called wireless communication terminal equipment is determined using a paging procedure provided in the base station of the home area.

12. The method according to claim 11, wherein the paging procedure is implemented according to a DECT standard.

13. The method according to claim 11, wherein at least one of the communication network and the sub-communication network is a public ISDN communication network.

14. The method according to claim 11, wherein the rerouting of the call is realized using an ISDN performance feature of "call deflection".

15. A method for controlling calls in a public ISDN communication network, calling, using a telephone number, wireless communication terminal equipment wirelessly connected to base stations of a home area, the base stations being connected to communication terminals of the communication network, and the wireless communication terminal equipment being additionally wirelessly connected to an ISDN sub-communication network of the ISDN communication network;

switching calls directed to a called wireless communication terminal equipment to an appertaining base station in the home area using the communication network,

availability of the called wireless communication terminal equipment being determined said appertaining base station in the home area;

rerouting the call, given non-availability of the called wireless communication terminal equipment, to the sub-communication network using the appertaining base station and using an ISDN performance feature of "call deflection".

16. The method according to claim 15, wherein a call setup for a rerouted call is initiated in the sub-communication network using a mobile telephone number of the called wireless communication terminal equipment, the rerouted call being initiated to the respective wireless communication terminal equipment.

17. The method according to claim 15, wherein availability of the called wireless communication terminal equipment is determined using a paging procedure provided in the base station of the home area.

18. The method according to claim 17, wherein the paging procedure is implemented according to a DECT standard.

## **ABSTRACT OF THE DISCLOSURE**

Calls (ar) directed to wireless communication terminal equipment (KE) wirelessly connected to base stations (BS-H) of a home area (H) and to a communication network (KN) are switched to the appertaining base station (BS-H) in the home area (H) using the communication network (KN). The availability of the called wireless communication terminal equipment (KE) is determined using the base station. Given non-availability of the called wireless communication terminal equipment (KE), the calls (ar) are rerouted to the communication network (KN) using the performance feature of "call deflection" provided in the base station (BS-H) in the home area (H). The method can be integrated into existing communication networks (KN) with minimal outlay.

## DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

### METHOD FOR CALL CONTROL OF COMMUNICATION TERMINAL EQUIPMENT WIRELESSLY CONNECTED TO COMMUNICATION NETWORKS

Case No. P-97,1957, the specification of which

(check  
one) ☒ is attached hereto.  
☐ was filed on \_\_\_\_\_, as  
Application Serial No. \_\_\_\_\_  
and was amended on \_\_\_\_\_  
(if applicable)

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims as amended by any amendment referred to above.

I acknowledge the duty to disclose to the United States Patent Office all information which is known to me to be material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, 1.56(a).<sup>1</sup>

I do not know and do not believe this invention was ever known or used in the United States of America before my or our invention thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to this application, that the same was not in public use or on sale in the United States of America more than one year prior to this application, and I believe that the invention has not been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months prior to this application, and that no application for patent or inventor's certificate on this invention has been filed in any country foreign to the United States of America prior to this application by me or my legal representatives or assigns, except as identified below:

I hereby claim foreign priority benefits under Title 35, United States Code, 119 of any foreign application(s) for patent or inventor's certificate listed below

Prior Foreign Application(s)

Number

Country

Date

19639608.5

Germany

September 26, 1996

and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the above listed application on which priority is claimed:

Prior Foreign Application(s)

Number

Country

Date

<sup>1</sup> (b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.



If no priority is claimed, I have identified all foreign patent applications filed prior to this application:  
Prior Foreign Application(s)  
Number Country Date

And I hereby appoint Messrs. John D. Simpson (Registration No. 19,842), Lewis T. Steadman (17,074), Dennis A. Gross (24,410), Steven H. Noll (28,982), Kevin W. Guynn (29,927), Robert M. Barrett, (30,142), Robert M. Ward (26,517), Brett A. Valiquet (27,841), Edward A. Lehman (22,312), James D. Hobart (24,149), Marvin Moody (16,549), Melvin A. Robinson (31,870), David R. Metzger (32,919), John R. Garrett (27,888), James Van Santen (16,584), William C. Stueber (16,453), and J. Arthur Gross (13,615) all members of the firm of Hill, Steadman & Simpson, A Professional Corporation

Telephone: 312/876-0200 Ext. 3491

my attorneys with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith and direct that all correspondence be forwarded to:

Hill, Steadman & Simpson  
A Professional Corporation  
85th Floor Sears Tower, Chicago, Illinois 60606

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or first inventor HANS-JOCHEN MORPER

Inventor's signature [Signature] Date 9/11/97

Residence 85253 Erdweg, Germany

Citizenship Germany

Post Office Address Nussstr. 10

85253 Erdweg, Germany

Full name of second joint inventor,  
(if any) \_\_\_\_\_

Inventor's signature \_\_\_\_\_ Date \_\_\_\_\_

Residence \_\_\_\_\_

Citizenship \_\_\_\_\_

Post Office Address \_\_\_\_\_

Full name of third joint inventor,  
(if any) \_\_\_\_\_

Inventor's signature \_\_\_\_\_ Date \_\_\_\_\_

Residence \_\_\_\_\_

Citizenship \_\_\_\_\_

Post Office Address \_\_\_\_\_



## Bescheinigung

Die Siemens Aktiengesellschaft in München/Deutschland hat eine Patentanmeldung unter der Bezeichnung

"Verfahren zur Verbindungssteuerung von drahtlos an Kommunikationsnetze angeschlossenen Kommunikationsendgeräten"

am 26. September 1996 beim Deutschen Patentamt eingereicht.

Die angehefteten Stücke sind eine richtige und genaue Wiedergabe der ursprünglichen Unterlagen dieser Patentanmeldung.

Die Anmeldung hat im Deutschen Patentamt vorläufig die Symbole H 04 Q und H 04 M der Internationalen Patentklassifikation erhalten.

München, den 27. August 1997  
Der Präsident des Deutschen Patentamts  
Im Auftrag

Aktenzeichen: 196 39 608.5

Rixner

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Additional name(s) of conveying party(ies) attached?  
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- ☒ Assignment ☐ Merger  
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Execution Date Sept 11, 1997

2. Name and address of receiving party(ies):  
Name: Siemens Aktiengesellschaft

Internal Address: \_\_\_\_\_

Street Address Wittelsbacherplatz 2

City 8000 Muenchen, Germany City \_\_\_\_\_ Zip: \_\_\_\_\_

Additional Name(s) & Address(es) attached ☐ Yes ☒ No

4. Application number(s) or patent number(s):  
If this document is being filed together with a new application, the execution date of the application is: Sept 11, 1997

A. Patent Application No.(s)

B. Patent No.(s)

P97,1957

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

**Hill, Steadman & Simpson, P.C.**

85th Floor Sears Tower  
233 S. Wacker Drive  
Chicago, IL 60606

6. Total number of applications and patents involved

1

7. Total Fee (37 CFR 3.41) ..... \$ 40.00

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DATE <u>9-17-97</u>	CLIENT <u>Siemens</u>	INVENTOR <u>[Signature]</u>	CLIENT NO. <u>[Blank]</u>	CASE NO. <u>P97,1957</u>	SER. NO. <u>[Blank]</u>	AMOUNT <u>40.00</u>	CHECK NO. <u>54562</u>
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# ASSIGNMENT

FOR a valuable consideration, the undersigned,

residing at **HANS-JOCHEN MORPER**  
**Nussstr. 10**  
**85253 Erdweg**  
**GERMANY**

hereby sell, assign and transfer unto Siemens Aktiengesellschaft, Wittelsbacherplatz 2, 80333 Muenchen, Germany, a German corporation, the whole right, title and interest in and to a certain invention or improvement in

## **METHOD FOR CALL CONTROL OF COMMUNICATION TERMINAL EQUIPMENT WIRELESSLY CONNECTED TO COMMUNICATION NETWORKS**

disclosed in an application for Letters Patent of the United States, prepared by the firm of Hill, Steadman & Simpson, A Professional Corporation of Chicago, Illinois, and executed of even date herewith, said application being identified in the office records of said firm as Case No. **P-97,1957**, and in our own records as Case No. **GR96P2259US**, and in and to the United States Letters Patent therefor, when issued, together with all improvements thereon and betterments thereof, all divisions, continuations and reissues thereof and substitutions of or for said application, and all rights and privileges under the Letters Patent that may be granted therefor, including the right to claim the benefit of an earlier filing date for the same invention in a foreign country.

I hereby authorize and request the Commissioner of Patents to issue the Letters Patent that may be granted for said invention or improvements to said Siemens Aktiengesellschaft, Wittelsbacherplatz 2, 80333 Muenchen, Germany.

For the same consideration, I hereby agree that I will promptly communicate to the aforesaid assignee or its assigns full and complete information concerning said improvements or betterments of the inventions disclosed in said application, and will cooperate at any time upon request of said assignee or its assigns, at its expense, in the procurement of patent protection to cover the inventions herein assigned and to be assigned, including the execution of new, divisional, continuing and reissue applications; will make all rightful oaths, will testify in any proceedings in the United States Patent Office or in the Courts, and generally will do everything lawfully possible to aid said assignee, its successors, assigns and nominees to obtain, enjoy and enforce proper patent protection for the inventions embraced within the terms of this document.

DATE: 9/11/92

H-J Morper  
Hans-Jochen Morper

WITNESSES:

Michael Unger, Sept. 9, 1992

A. S., Sept. 9, 1992

HILL, STEADMAN & SIMPSON  
A PROFESSIONAL CORPORATION  
ATTORNEYS AND COUNSELORS AT LAW  
85TH FLOOR SEARS TOWER  
CHICAGO, ILLINOIS 60606

COPY

September 17, 1997

THE COMMISSIONER OF PATENTS  
Washington, D.C. 20231

Sir:

Transmitted herewith for filing is the patent application of P97,1957

Inventor: Hans-Jochen Morper

For: METHOD FOR CALL CONTROL OF COMMUNICATION TERMINAL EQUIPMENT  
WIRELESSLY CONNECTED TO COMMUNICATION NETWORKS  
Applicant claims the benefit of the filing date of a corresponding German application No.  
19639608.5 filed in Germany on September 26, 1996 under the provision of 35 U.S.C.  
119.

- ☐ 1 sheet(s) of drawings.  
☒ An assignment of the invention to Siemens Aktiengesellschaft  
☒ A certified copy of a German Application.  
☐ An Amendment "A" Accompanying filing of new application.  
☐ Information Disclosure Statement.  
☐ Letter under Rule 37 CFR 1.41(c).  
☐ Express Mail Letter.

CLAIMS AS FILED				
(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) BASIC FEE \$770.00
TOTAL CLAIMS	18-20			
INDEPENDENT CLAIMS	3-3			
	ANY MULTIPLE DEPENDENT CLAIMS? ( ) YES (X) NO			
			TOTAL FILING FEE ->	\$770.00

☒ The Commissioner is hereby authorized to charge any additional fees which may be required in connection with this application, or credit any overpayment to Account No. 08-2290. A duplicate copy of this sheet is enclosed.

☒ A check in the amount of \$770.00 to cover the filing fee is enclosed.

Very respectfully,  
HILL, STEADMAN & SIMPSON  
A Professional Corporation

By Steve H. Noll #28982

DATE	9-17-97
HOLDER BUSINESS FORMS	0318992
CLIENT	Siemens
INVENTOR	Morper
CLIENT NO.	P97,1957
CASE NO.	P97,1957
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